92-297

Supreme Court, U.S.
FILED
AUG 14 1992
OFFICE OF THE CLERK

No. ——

IN THE

Supreme Court of the United States

OCTOBER TERM, 1992

JEFF KOONS,

Petitioner,

v.

ART ROGERS and SONNABEND GALLERY, INC.,

Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Second Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether a work of art that would otherwise qualify for the copyright defense of "fair use" becomes a form of actionable commercial exploitation simply because its creator was paid for that work.

2. Whether an artist who imitates but transforms a prior work in order to criticize what it represents may be held liable for copyright infringement simply because the two works are superficially similar and the prior work is not sufficiently well known to be a recognizable object of the critique.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Jeff Koons seeks review of a decision of the United States Court of Appeals for the Second Circuit holding that a fine-art sculpture created by him infringed the copyright in a photograph previously published as a notecard by respondent Art Rogers.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Second Circuit is reported at 960 F.2d 301, and reprinted at Pet. App. 1a. The opinions of the United States District Court for the Southern District of New York are reported at 751 F. Supp. 474 and 777 F. Supp. 1 and reprinted at Pet. App. 25a and 41a.

JURISDICTION

The Court of Appeals entered judgment on April 2, 1992, and denied a timely petition for rehearing on

May 18, 1992. The jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1254(1).

STATUTES INVOLVED

Section 107 of title 17 of the United States Code provides as follows:

> Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—
>
> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
>
> (2) the nature of the copyrighted work;
>
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
>
> (4) the effect of the use upon the potential market for or value of the copyrighted work.

STATEMENT

This case involves a copyright infringement claim brought by respondent Art Rogers, a professional photographer who in 1980 was commissioned to shoot a black-and-white portrait of two people holding eight puppies. In 1984, Rogers licensed the publication of this photograph on notecards distributed to stores around the country. Petitioner Jeff Koons is a prominent artist and sculptor who in 1988 created a large, brightly colored sculpture entitled *String of Puppies*. This sculpture was modeled to a considerable extent on the figures in the

notecard. It was initially exhibited at the Sonnabend Gallery in New York as part of a body of 20 sculptural works under the title "Banality Show."

Like the other art works that Koons produced for this exhibition, *String of Puppies* was intended in part as a criticism of a commercial, mass-produced image from popular culture. As the Second Circuit recognized, petitioner "works in an art tradition dating back to the beginning of the twentieth century," Pet. App. 4a—a tradition characterized by use of commonplace images or objects in the creation of new works. Many contemporary artists, sometimes referred to as "post-modernists," "draw upon the artistic movements of Cubism and Dadaism, with particular influence attributed to Marcel Duchamp, who in 1913 became the first to incorporate manufactured objects (readymades) into a work of art." *Id.* at 15a. They typically incorporate "images into works of art to comment critically both on the incorporated object and the political and economic system that created it." *Id.* In this process, "the meaning of the original object [is] extracted and an entirely new meaning set in place." *Id.* at 4a.[1] One well-known example is the work of Andy Warhol. Jeff Koons is recognized as one of the most important contemporary visual artists in this tradition.[2]

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[1] *See* C. Owens, "The Allegorical Impulse: Toward a Theory of Postmodernism," in *Art After Modernism* 205 (B. Wallis ed. 1989) ("The appropriated image may be a film still, a photograph, a drawing; it is often itself already a reproduction. However, the manipulations to which these artists subject images work to empty them of their resonance, their significance, their authoritative claim to meaning."). *See generally* H.H. Arnason, *The History of Modern Art* 635-91 (3d ed. 1986); K. Varnedoe & A. Gopnik, *High & Low: Modern Art/Popular Culture* 369-403 (1990).

[2] See Gibson, "Decade in Review," *Sculpture*, May/June 1989, at 23 ("Koons' kitchen-objects represent the climax of the so-called Simulationist movement, in which artists make and exhibit works of art based on real-world commodities to draw attention to, and criticize, what they view as the excessively commercial character of the art market."); M. Brenson, *Art: Whitney Biennial's New Look*, N.Y. Times, Apr. 10, 1987 at C24 ("Mr. Koons has formulated one of the

Thus, in making *String of Puppies*, petitioner instructed the artisans assisting him to recreate in sculptural form various features of the Rogers notecard because his goal was to reproduce what he considered a typical example of popular culture. But Koons also sought to transform the notecard image in order to make his own radically different artistic statement. This transformation included a number of very significant changes —using the sculptural medium and a larger-than-life scale, adding vivid painting (especially the blue on the dogs), adding daisies to the hair of the two people and exaggerating their facial expressions for a vacuous effect, and placing a bulbous nose on each puppy.[3] As a result of these changes, the overall aesthetic effect of the sculpture is quite distinctive. The notecard presents a scene that the court below described as "charming", Pet. App. 11a, while Koons' sculpture is highly disturbing. As petitioner put it, his goal was to take "the sculpture out of the realm of reality into the realm of unreality but without eliminating a sense of believability." CA Jt. App. at 789.[4] He felt that he had "stripped away entirely the personality of the notecard picture and substituted [his] own values and [his] own message." *Id.* at 791.

In keeping with Koons' general practice, only three edition copies of the sculpture exist.[5] No further copies were

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most jaded and puritanical statements made by an artist about consumer culture.").

[3] Photographs from the record showing the notecard, a frontal view of the Koons sculpture, and the sculpture displayed as part of the larger Banality show are reproduced in the appendix to this petition at pages 48a, 49a & 50a.

[4] *See also* K. Varnedoe & A. Gopnik, *supra*, at 396 (describing the "Banality" show) ("Koons's figurines were shocking because of the way they looked. They were nightmarish—devil dolls, in which the insipid language of the cartoons' over-accentuated contours and biscuit glazes was suddenly made hard and staring.").

[5] An initial proof, traditionally known as an "artist proof," was kept by Koons as a personal record of his work and was not made available for purchase.

ever intended (and New York law would forbid further copies). All three edition works were purchased by collectors for a total of $367,000. Respondent's complaint, filed in 1989 in the U.S. District Court for the Southern District of New York, claimed copyright infringement and unfair competition under the Lanham Act and state law. On December 10, 1990, the district court granted respondent's motion for summary judgment on the issue of copyright infringement. Pet. App. 40a. It held that the photograph and the sculpture are "substantially similar," and rejected the asserted defense of "fair use" as a matter of law.[6]

On appeal, the United States Court of Appeals for the Second Circuit affirmed. It agreed that the two works are substantially similar, adopting an approach that asked only whether elements of the works are recognizably similar without taking into account their overall differences in terms of aesthetic appeal or message. Pet. App. 10a. With respect to the issue of "fair use," the Second Circuit referred to each of the four factors set out in the statute. 17 U.S.C. § 107. Disregarding Koons' own affidavit, it held, first, that the "purpose" of Koons' sculpture was primarily for profit and thus exploitive. Pet. App. 14a. In so doing, it relied on the fact that collectors had paid high prices for the sculpture. The court flatly rejected as inapplicable the statutory concepts of "criticism" or "comment." *Id.* It also refused to consider the sculpture as a form of "parody," construing this term to apply only where the original work is sufficiently well known that it

[6] The court held that the question of damages presented disputed issues requiring a trial. It also ruled, however, that Rogers should receive the artist's proof of the sculpture, even though Koons had never offered it for sale. Believing that any actual turnover of his artist's proof would not be required until the end of the case, Koons loaned it to a museum in Germany for a temporary exhibition. The district court held him in contempt and ordered the proof returned to Koons' warehouse in New York. This aspect of the case is not raised in the instant petition.

will be recognized as the object of the parody by viewers of the later work. *Id.* at 16a.

Turning to the second and third factors, the court of appeals then held that the creative and imaginative "nature" of the photograph militated against a finding of fair use, and that the "amount and substantiality" of the copying done by Koons was greater than would have been permitted even in a true parody case. *Id.* at 17a. Finally, the court of appeals ruled that there was no possible dispute with respect to the fourth fair-use factor, the "effect of the use on the potential market for or value of the copyrighted work." Here, petitioner had argued that the two works appealed to entirely different audiences and that the record contained no evidence establishing even a meaningful possibility (much less a likelihood) of market injury. The court, however, invoked a presumption of market injury based on its prior conclusion that petitioner's work was "primarily commercial in nature." *Id.* at 20a (citing *Sony Corp. of America v. Universal City Studios*, 464 U.S. 417, 451 (1984)). Applying this presumption, it concluded that it was "obviously not implausible" that the sculpture could interfere with a sale by respondent of the right to produce a derivative sculpture based on the photograph, Pet. App. 20a,[7] even though a true derivative would convey the "charming" message of the Rogers photograph, while Koons' "horrific" sculpture did not do so.

REASONS FOR GRANTING THE WRIT

The central issue in this case is what standards a court should apply when a plaintiff in an infringement action seeks to rebut a "fair use" defense by labelling the defendant's work "commercial" and thus exploitive. As the Second Circuit's decision illustrates, application of proper

[7] The court also unjustifiably speculated that Koons might sell photographs of his sculpture, thereby limiting "Rogers' potential market for the sale of the notecards, in addition to any other derivative use he might plan." Pet. App. 20a.

standards to resolve the question of commerciality is critical, because a court's characterization of a challenged work as commercially exploitive automatically leads to a finding of liability for infringement. At the same time, that decision demonstrates the need for clarification of the applicable standards—both in fair-use cases generally and in the specific context of cases involving works of parody or satire. In the absence of such guidance, the lower courts are producing inconsistent and unpredictable decisions, often demonstrating little awareness of the basic principles that should distinguish actionable infringement from fair use. Moreover, if left undisturbed, the Second Circuit's ruling will have a severe practical impact, not only on artists like petitioner working in the "post-modern" tradition but also on other artists and authors who may wish to "use" prior works in legitimate, and often critical, ways.

While this Court has in recent years addressed various aspects of fair use, it has not established clear rules for applying the first factor set forth in the statute: "the purpose and character of the use, including whether such use is of a commercial nature." 17 U.S.C. § 107. The need for such clear rules was greatly heightened when this Court, in *Sony Corp. of America v. Universal City Studios*, created new presumptions that commercial uses are "unfair" and, more specifically, that any commercial use causes market injury to the creator of the prior work. 464 U.S. at 449, 451. After *Sony*, a court's inquiry into "commercial use" under the first fair-use factor has become critical to a determination of market injury, the "'most important, and indeed, central'" factor in the fair-use context. *Stewart v. Abend*, 110 S. Ct. 1750, 1769 (1990) (quoting 3 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 13.05[A], at 13-102.4 ("Nimmer")). Indeed, as this case illustrates, labelling a work as commercial exploitation, when combined with the *Sony* presumptions, permits a court to bypass altogether a meaningful separate inquiry into market injury.

This approach might not be a matter of serious concern if the Second Circuit had addressed the "commercial use" question in a way that took into account the fundamental purpose of the fair-use privilege. This privilege is designed to allow subsequent authors and artists to use prior works in the creation of new ones that communicate new and distinct messages and do not impinge on valid commercial rights in the prior works. But the court adopted reasoning that has little or nothing to do with this underlying purpose. It focused first on the fact that petitioner was paid for his sculpture, even though that fact is equally present in virtually every fair-use case. It then ruled out characterization of the sculpture as a form of social criticism or "parody" based on another fact (the relative obscurity of the Rogers photograph) that has no logical connection to the policies underlying the fair-use defense.

The result was a ruling that ultimately makes no sense. While Koons' idiosyncratic sculpture certainly resembles the Rogers "charming" photograph in a superficial way, it also constitutes an independent act of expression about the "banality" of those aspects of our culture typified by the photograph. To suggest that the sculpture, with its own distinctive message and audience, affected the market for the photograph or for derivative works faithfully based on the photograph is absurd. And it is equally absurd to suggest that Koons selected the photograph as a model in order to "exploit" the creativity of respondent.

That the Second Circuit could nevertheless find infringement as a matter of law in this case is, by itself, compelling evidence of the need for action by this Court. Copyright law strikes a "difficult balance" between two goals: (1) safeguarding valid commercial rights of authors and artists in order to encourage their expression and (2) leaving ample room for additional creative efforts by others. *Sony Corp. of America v. Universal City Studios*, 464 U.S. at 429. The fair-use privilege helps to

strike this balance, by preventing " 'rigid application of the copyright statute when . . . it would stifle the very creativity which that law is designed to foster.' " *Stewart v. Abend*, 110 S. Ct. at 1768 (quoting *Iowa State Univ. Research Found. v. American Broadcasting Cos.*, 621 F.2d 57, 60 (2d Cir. 1980)). The Second Circuit's almost reflexive condemnation of petitioner's work as commercial exploitation—an approach that is, unfortunately, far from unique—demonstrates the need for review by this Court in order to ensure that copyright law continues to be a vehicle for encouraging, rather than suppressing, desirable and legitimate forms of expression.

I. THE RULING BELOW RAISES ISSUES OF CRITICAL IMPORTANCE TO THE PROPER ADMINISTRATION OF THE COPYRIGHT LAWS.

1. The importance of this case reflects the central role of the fair-use doctrine in establishing the proper scope of copyright protection. Like any copyright case, this one ultimately requires assessment of specific facts relating to the features of unique creative works. But the *approach* adopted by the Second Circuit severely distorts that assessment and thus threatens a more general disruption of the careful balance reflected in copyright law.

"The primary objective of copyright is not to reward the labor of authors, but '[t]o promote the Progress of Science and useful Arts.' " *Feist Publications, Inc. v. Rural Tel. Serv. Co.*, 111 S. Ct. 1282, 1290 (1991) (citations omitted). In pursuit of this goal, copyright law joins patent law in seeking to respect *both* "the interests of authors and inventors in the control and exploitation of their writings and discoveries on the one hand, and society's competing interest in the free flow of ideas, information, and commerce on the other hand." *Sony Corp. of America v. Universal City Studios*, 464 U.S. at 429.[8]

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[8] *See also Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 109 S. Ct. 971, 975 (1989) ("From their inception, the federal patent laws have embodied a careful balance between the need to promote

At its heart, copyright law thus involves a utilitarian calculus about what degree of protection for original works will foster the greatest degree of creative activity. In this process, " 'reward to the [copyright] owner [is] a secondary consideration,' " justified only as a means to " 'induce release to the public of the products of his creative genius.' " *Id.* (quoting *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948)).

The fair-use doctrine helps to strike the proper balance by authorizing artists and authors to "use" prior works in the creation of new ones that express new, and often critical, messages without depriving existing copyright holders of the commercial incentives that encourage creativity. *See Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 549-50 (1985); *id.* at 581 n.2 (Brennan, J., dissenting). Drawing from the case law, Congress in 1976 listed four factors to be applied to evaluating a fair-use defense.[9] This codification, however, has not proved successful in providing structure and predictability in this important area of the law. The statutory factors have an "almost infinite elasticity . . . [and a] concomitant inability to resolve difficult questions." 3 Nimmer, § 13.05[A][5], at 13-102.6. All too often, "the factors . . . tend to degenerate into post-hoc rationales for antecedent conclusions, rather than serving as tools for analysis." *Id.* at 13-102.10.

The solution, as this Court has suggested, is to give primary importance to the fourth statutory factor: the actual or potential effect of the subsequent use on the mar-

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innovation and the recognition that imitation and refinement through imitation are both necessary to invention itself and the very lifeblood of a competitive economy.").

[9] These four factors are: "(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work." 17 U.S.C. § 107.

ket value of the prior work or its derivatives. *See Stewart v. Abend*, 110 S. Ct. at 1769; *Harper & Row, Publishers, Inc. v. Nation Enters*, 471 U.S. at 566. Such an approach correctly looks to whether the new work in some way fulfills the same "function" as the prior work, *see* Nimmer § 13.05[B], and thus threatens to interfere with the commercial incentives that are the "engine of free expression" under the copyright laws, *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. at 558.

The Second Circuit's decision in this case, however, exemplifies a far less discerning approach, one that courts tend to apply when they first address another factor—the "purpose and character of the use"—and determine that the use was "commercial" in nature. As we have suggested, this problem has arisen because this Court created a presumption that commercial use causes market injury, *Sony Corp. of America v. Universal City Studios*, 464 U.S. at 451, but has not established a workable definition of "commercial use" that provides predictable standards or that would justify the *Sony* presumption across the board. As a result, a subsequent use of a prior work may undeservedly be labelled "commercial" in nature, thereby effectively forfeiting the fair-use defense, even where the use communicates a new and distinct message and even where there is no real evidence of actual or potential market injury.

2. Thus, here, the Second Circuit placed great reliance on a single fact in determining that petitioner was engaged in commercial exploitation: he was well paid for his sculpture. *See* Pet. App. 14a ("Koons' substantial profit . . . militates against the finding of fair use").[10]

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[10] *See also* Pet. App. 4a (Koons' "works sell at very substantial prices, over $100,000"); *id.* at 6a ("Three of the four copies made were sold to collectors for a total of $367,000 . . . ."). The court also saw fit to note that "[w]hile pursuing his career as an artist, [petitioner] also worked until 1984 as a mutual funds salesman, a registered commodities salesman and broker, and a commodities futures broker." *Id.* at 4a.

In so doing, the court was not alone. The case law in the lower courts reflects abundant confusion over whether receipt of compensation renders a particular use "commercial" under the first statutory factor.[11] In reality, however, it should be obvious that the all-important commercial/noncommercial distinction cannot depend on the mere fact of receipt of compensation. After all, artists and authors of fiction—just like the critics, news reporters and scholars whose works are cited in the statute as examples of presumptively "fair" use[12]—nearly always seek to be paid for what they create.[13]

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[11] *See Hustler Magazine, Inc. v. Moral Majority, Inc.*, 796 F.2d 1148, 1152 (9th Cir. 1986) (reproduction of magazine excerpt for purposes of fundraising by nonprofit groups constitutes commercial use); *Brewer v. Hustler Magazine, Inc.*, 749 F.2d 527, 529 (9th Cir. 1984) (reproduction of photograph in magazine was a commercial use); *Iowa State Univ. Research Found., Inc. v. American Broadcasting Cos.*, 621 F.2d 57, 61 (2d Cir. 1980) (production of biography of public figure for network broadcast constitutes commercial use); *Association of American Medical Colleges v. Mikaelian*, 571 F. Supp. 144, 152 (E.D. Pa. 1983) (use for educational purposes by for-profit organization is commercial), *aff'd per curiam*, 734 F.2d 3 (3d Cir. 1984). *But see New Era Publications Int'l ApS v. Carol Publishing Group*, 904 F.2d 152, 156 (2d Cir.) (publication of biography is noncommercial despite anticipated profits), *cert. denied*, 111 S. Ct. 297 (1990); *Rosemont Enters., Inc. v. Random House, Inc.*, 366 F.2d 303, 307-08 (2d Cir. 1966) (same), *cert. denied*, 385 U.S. 1009 (1967); *Haberman v. Hustler Magazine, Inc.*, 626 F. Supp. 201, 210-11 (D. Mass. 1986) (reproduction in for-profit magazine of prior works for purposes of commentary is noncommercial). *See also Maxtone-Graham v. Burtchaell*, 803 F.2d 1253, 1262 (2d Cir. 1986) ("The commercial nature of a use is a matter of degree, not an absolute . . . ."), *cert. denied*, 481 U.S. 1059 (1987).

[12] 17 U.S.C. § 107 ("[T]he fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research, is not an infringement of copyright.")

[13] Nor can the outcome turn on the amount of the compensation. It hardly makes sense to give lesser leeway to an artist merely because his prominence in the art world makes all of his works more valuable.

This Court has at least suggested the proper answer to this problem, in its application of the fair-use factors in *Harper & Row, Publishers, Inc. v. Nation Enters.*, *supra*. There, the Court asked whether the use had the purpose of "supplanting [one of] the copyright holder's commercially valuable right[s]." 471 U.S. at 562. It concluded that a magazine's quotation of extracts from unpublished memoirs was commercial because the magazine had usurped the right of first publication that had already been sold to others. *Id.* Applied generally, this approach would mean that the first fair-use factor would be assessed in conjunction with the fourth factor—potential market injury. A challenged use would be "commercial" if it had the potential to supplant demand for the original or appropriated a valuable commercial right that could otherwise have been sold in the marketplace.[14] Such an approach would assure that functional, market-based considerations always retain their primary role in determining whether a particular use will interfere with the commercial incentives that promote free expression.

Here, as we have suggested, that approach could not have led to condemnation of petitioner as a commercial exploiter as a matter of law. Petitioner here relied on the obvious fact that his highly disturbing, limited-edition sculpture, part of a gallery show criticizing the "banality" of popular culture, in no way competed in the marketplace with respondent's photograph or its potential derivatives. This meant that the value of the photograph to Rogers remained unaffected. The Second Circuit nevertheless

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[14] The Second Circuit repeatedly quoted this Court's statement in *Harper & Row, Publishers, Inc. v. Nation Enters.* that the crux of the issue is "whether the user stands to profit from exploitation of the copyrighted material without paying the customary price." Pet. App. 14a, 16a (quoting 471 U.S. at 562). It seemed to believe that Koons' failure to pay a "customary price" by itself rendered his use commercial. But this is obviously circular: it is the failure to pay a "price" to the copyright holder that raises the fair-use issue in the first place. The real question is whether the use makes it more difficult to sell the original work, or derivative rights, *to others*.

avoided any real assessment of this question, by ignoring the obviously distinctive qualities of the Koons sculpture, labelling it a form of commercial exploitation, and thereby simply presuming market injury that was not proved.[15]

3. To be sure, after focusing on Koons' profits, the court of appeals then went on to consider his "contention that the primary purpose of the use was for social comment." Pet. App. 14a. Here, however, it made another fundamental error—holding that while the Koons sculpture might be a "satirical critique of our materialistic society," he could not escape the label of "commercial exploiter" because the object of his critique was not sufficiently well known to be recognizable to those who would view the sculpture. Pet. App. 16a. As a result of this fact, the court held, the sculpture was not a "parody" or "satire" of the photograph, and thus did not qualify for heightened protection.

This aspect of the decision below is also important. Parody and satire, as literary genres, have "thrived from the time of Chaucer," and are "deserving of substantial freedom—both as entertainment and as a form of social and literary criticism." *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541, 545 (2d Cir.), *cert. denied*, 379 U.S. 822 (1964). In this century, as noted above, it has become commonplace for artists also to use existing images in the creation of new works that criticize what those images represent. These works have become a key part of the "dialogue" between mass culture and its social critics.

As one would expect, works that criticize prior works through parody or satire have long been recognized as

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[15] Respondent offered, in support of his motion for summary judgment, evidence establishing at most a theoretical possibility of sales of the right to produce a derivative sculpture based on his photograph. Petitioner offered affidavits directly contradicting this showing. Because of the *Sony* presumption, the court of appeals ignored this factual dispute and simply speculated that some market injury was "not implausible." Pet. App. 20a.

primary examples of fair use. When such works are challenged under the copyright laws, "copying" in one sense is both undisputed and obvious. But the law is nevertheless receptive to such copying, for two reasons. First, "many parodies are intended as criticisms of the original, and for the author to be able to suppress criticism would interfere with the literary marketplace and distort the test of time." R. Posner, *Law and Literature: A Misunderstood Relation* 350 (1988). Second, "a parody is not intended to be a substitute for the original . . . [and] therefore, except insofar as it is effective criticism, the parody should not diminish the sales of the original author's work and indeed may increase them." *Id.* In sum, this form of copying, in general, does not interfere with any interests that prior copyright holders can legitimately expect to have protected.

Thus, in this case, petitioner openly and deliberately made use of the Rogers photograph in the creation of his sculpture. But the Koons sculpture embodied a deliberate aesthetic transformation of that prior image. The faces of the people were rendered cartoon-like and blank. The dogs, painted blue and given bulbous noses, also had the appearance of cartoon characters. The work as a whole was included in a show condemning the "banality" of popular culture in a prominent New York gallery. On such facts, it can hardly be supposed that petitioner was competing for respondent's audience or otherwise affecting the demand for respondent's "charming" photograph.[16]

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[16] The Second Circuit's failure to recognize the essential differences between the Rogers photograph and the Koons sculpture was also reflected in its handling of a separate issue—"substantial similarity." This requirement, which applies even where, as here, the defendant concedes some degree of actual copying, 3 Nimmer, § 13.03[A], at 13-23, calls for a qualitative determination whether the nature and degree of the copying implicates copyright concerns by affecting the legitimate interests of the creator of the original, *see id.* at 13-45 to -47. In cases like this one, courts often ask whether the "total concept and feel" of the two works is substantially similar. *See, e.g., Aliotti v. R. Dakin & Co.*, 831 F.2d 898, 901

The Second Circuit nevertheless held that such an artistic approach is *per se* illegitimate in those cases where the work being criticized, while typical of some aspect of culture, is not itself well known. This holding is supported by some but not all of the rather confused case law in this field.[17] But such a rule ultimately makes no sense. The policies underlying copyright provide no basis for drawing a distinction between parodies of famous works and parodies of lesser-known works that typify something about our culture. *Cf. Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. at 559 ("It is fundamentally at odds with the scheme of copyright to accord lesser rights in those works that are of greatest importance to the public."). Regardless of the celebrity of the work being criticized, a new creation that sends a different message to a different audience does not supplant the demand for the earlier work and thus does not implicate copyright concerns. *See* 3 Nimmer § 13.05[B], at 13-102.12 ("But if regardless of medium, the defendant's work, although containing substantially similar material, performs a different function than that of the plaintiff's, the defense of fair use may be in-

(9th Cir. 1987) (citing cases). Here, however, the Second Circuit did not even view the actual sculpture, and asked only whether a lay observer would recognize that the Koons sculpture was based in part on the Rogers photograph, Pet. App. 11a—a fact that petitioner had already conceded. It thus gave no weight to the possibility that petitioner's transformation of the photograph, creating an entirely different aesthetic impression, might lead a fact-finder to find no substantial similarity.

[17] *Compare Elsmere Music, Inc. v. National Broadcasting Co.*, 482 F. Supp. 741, 746 (S.D.N.Y.) ("the issue to be resolved . . . is whether the use in question is a valid satire or parody, and not whether it is a parody of the copied song itself"), *aff'd on opinion below*, 623 F.2d 252 (2d Cir. 1980), *with MCA, Inc. v. Wilson*, 677 F.2d 180, 185 (2d Cir. 1981) (copyrighted work must be "at least in part an object of the parody"), *and Walt Disney Productions v. Air Pirates*, 581 F.2d 751, 758 n.15 (9th Cir. 1978) (where prior works are "not also an object of the parody," the "need to conjure them up would be reduced if not eliminated"), *cert. denied*, 439 U.S. 1132 (1979).

voked."),[18] Moreover, there are good reasons relating to artistic authenticity why an artist might choose to base his critique of popular culture on a real (although relatively obscure) image.[19]

The flimsiness of the court's reasoning is apparent from its suggestion that petitioner *could* have mounted a parody defense, if only he had displayed the Rogers photograph with his sculpture. Pet. App. 16a (audience awareness of original "may come from the fact that . . . its existence is in some manner acknowledged by the parodist in connection with the parody"). If the scope of fair use in the parody context is to reflect the underlying goals of copyright, the presence or absence of such a display cannot be a critical factor in the analysis. After all, open acknowledgement of a prior source does not alter the commercial impact of a parody.

Instead, in parody cases as elsewhere, the determination whether a use is presumptively legitimate or commercially exploitive should be undertaken in a manner consistent with this Court's analysis in the *Nation* case. It should turn on whether the new work takes something of value from the prior author or artist—by fulfilling demand for the original or by basing its own appeal in whole or in part on the creative efforts reflected in the

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[18] The Second Circuit stated that allowing parodies of relatively unknown works would mean that there is "no practicable boundary to the fair use defense." Pet. App. 16a. This, of course, is not true. Well-known works are hardly subject to unlimited copying under current standards. A purported parodist of a famous work must show that he in fact is communicating a new and critical message and not engaging in commercial exploitation. *See* pp. 17-18 *infra*. Precisely the same limitation would apply to works making use of lesser-known images.

Indeed, it is the Second Circuit's approach that is truly impracticable. Recognizability is hardly an "either/or" proposition. It is a matter of degree, and depends largely on the particular audience considered.

[19] It would contravene the very essence of the post-modern artistic tradition for an artist like Koons to make up images intended to represent popular culture, rather than incorporating real ones.

prior work. The question should be whether the "parody" is truly a work of criticism, with a distinct message and audience, or is merely an effort to capitalize on the appeal of the original to the commercial detriment of its creator. *See* R. Posner, *supra*, at 350 (drawing a distinction between critical "parodies" and noncritical "burlesques," which merely borrow from a prior work for humorous effect and should not be authorized without consent).

The lower courts have groped toward a recognition of this principle, but without establishing a clear and workable rule. In some cases, where the original work and the "parody" perform different functions in separate genres, the absence of commercial exploitation has been readily recognized. *See, e.g., Berlin v. E.C. Publications, Inc.*, 329 F.2d at 545 (publication of a satirical version of song lyrics in a humor magazine had "neither the intent nor the effect of fulfilling the demand for the original"); *Haberman v. Hustler Magazine, Inc.*, 626 F. Supp. 201, 211 (D. Mass. 1986) ("It does not appear that [the] reproduction of Haberman's postcards was intended to increase sales of the magazine and, thus, in this fashion, improperly capitalize on Haberman's work."); *id.* ("Haberman markets his works as fine arts photographs and postcards. The *Hustler* reproductions . . . would not serve as suitable substitutes for someone who wished to collect the art . . . ."). Where, however, the two works are in the same genre (*e.g.*, two performed or recorded songs, or two television shows) there remains substantial doubt about when a parody's distinctive message is enough to negate the charge of commercial exploitation. *See MCA, Inc. v. Wilson*, 677 F.2d 180, 185 (2d Cir. 1981) ("We are not prepared to hold that a commercial composer can plagiarize a competitor's copyrighted song, substitute dirty lyrics of his own, perform it for commercial gain, and then escape liability by calling the end result a parody or satire on the mores of society."); *Warner Bros. v. American Broadcasting Cos.*, 654 F.2d 204, 211 (2d Cir. 1981) (involving Superman

and the television show "Greatest American Hero") ("we question whether the [parody] defense could be used to shield an entire work that is substantially similar to and in competition with the copyrighted work"). *But see Fisher v. Dees*, 794 F.2d 432, 438 (9th Cir. 1986) (involving the song "When Sunny Gets Blue" and a recorded parody "When Sunny Sniffs Glue") ("The two works do not fulfill the same demand. Consequently, the parody has no cognizable economic effect on the original."); *Acuff-Rose Music, Inc. v. Campbell*, 754 F. Supp. 1150, 1153-59 (M.D. Tenn.) (following *Fisher* on similar facts), *app. dismissed*, 929 F.2d 700 (6th Cir. 1991).[20]

Under any view, this case should be seen as one involving a true parody. There may well be cases where a purported parody is nothing more than an effort to appropriate valuable features of a prior work without bothering to create an entirely new one. *See MCA, Inc. v. Wilson*, 677 F.2d at 185 (purported parody song simply sought to capitalize on a popular tune). But here there could be no suggestion that the Koons sculpture lacked a critical message or that its commercial value was enhanced in any way by the selection of the Rogers photograph as a starting point. One reason for this, as the Second Circuit recognized, was that few people who viewed the sculpture were likely even to be aware of the photograph. Yet, ironically, this fact was treated as a decisive consideration confirming that Koons acted "in bad faith, primarily for profit-making motives." Pet. App. 17a.

Petitioner was thus put in a classic "double bind." If he had chosen a well-known image as the basis for his critique, he might have been accused of exploiting existing public recognition. When he chose instead an image

[20] Appropriate disapproval of works that merely "burlesque" prior works for humorous effect, without *criticizing* what those works represent, may well explain the comments in the case law suggesting that a parody must be in part a critique of the work used in its creation. *See* note 17 *supra*.

that typified popular culture but was not well known—at least in the world where his works are viewed and sold—he was labelled a commercial exploiter precisely because his work did not "conjure up" recognition of a prior work. This determination, in turn, led inexorably to a presumption of market injury and a denial of the fair-use defense.[21]

II. THIS CASE MERITS REVIEW BY THIS COURT.

This case involves issues of general importance meriting review by this Court. The decision below is perhaps the most glaring, but hardly the first, example of the difficulties that the lower courts have had in determining whether works are "commercial" and in applying copyright concepts to critical and parodic works. Moreover,

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[21] The court of appeals also ruled that petitioner had used much more of the photograph than was necessary for a valid parody. Pet. App. 18a (applying the third fair-use factor of the "amount and substantiality" of the copying). While some courts have adopted a similar limitation, *see, e.g., Fisher v. Dees*, 794 F.2d at 439 (parody may take "no more from the original than is necessary to accomplish reasonably its parodic purpose"), such a rule serves no legitimate purpose in a case involving a true parody that has a distinct message and audience and does not exploit the commercial value of the original. *See Elsmere Music, Inc. v. National Broadcasting Co.*, 623 F.2d 252, 253 n.1 (2d Cir. 1980) *(per curiam)* ("A parody is entitled at least to 'conjure up' the original. Even more extensive use would still be fair use, provided the parody builds upon the original, using the original as a known element of modern culture and contributing something new for humorous effect or commentary."); 3 Nimmer § 13.05[C], at 13-102.25 ("But short of such near-verbatim identity of content, the disparity of function between a serious work, and a satire based upon it, will sometimes justify the defense of fair use even where substantial similarity exists."); *cf. Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. at 550 ("'[A] reviewer may fairly cite largely from the original work, if his design be really and truly to use the passages for the purposes of fair and reasonable criticism.'") (quoting *Folsom v. Marsh*, 9 Fed. Cas. 342, 344 (C.C.D. Mass. 1841)); *Sony Corp. of America v. University City Studios*, 464 U.S. at 447-56 (even total duplication of a prior work may sometimes constitute fair use).

if left undisturbed, the Second Circuit's eager condemnation of petitioner's work as "wilful and egregious" "piracy," Pet. App. 23a, 18a, will have serious practical consequences, inhibiting the creativity of many other artists and authors.

The above discussion shows, at the very least, that this area of the law is grossly in need of clarification. By virtue of the *Sony* presumptions, identification of "commercial" uses of prior works has taken on enormous importance. Yet the courts are far from reaching any consensus about how to make such a determination—sometimes focusing on the profitability of a work but sometimes focusing (more appropriately in our view) on the impact of the work on the commercial interests of the creator of a prior work. *See* note 11 *supra*. The result is a series of decisions that provide little guidance to artists and authors and tend to reflect, more than anything else, the visceral reactions of judges to the merits of particular creative efforts.

This case, involving a new work that sought to criticize the very essence of a prior work, provides an appropriate vehicle for addressing this problem. Parodists, satirists, and other critics, after all, nearly always seek payment for what they produce. A rule labelling such works, on that basis, as "commercial" and therefore presumptively "unfair" would work a major change in the latitude traditionally accorded to those who seek to express themselves through parody.

Moreover, by granting review in this case, the Court could also address the distinctive problems raised by parodies that continue to plague the lower courts. As we have noted, the existing case law is somewhat inconsistent with respect to whether a purported parody must directly criticize a prior work that is recognizable to the audience. *See* note 17 *supra*. The courts are also confused about how to separate true parodies from what Judge Posner has called "burlesques," which simply exploit the popu-

larity of features of prior works. *See* pp. 18-19 *supra*. Such recurrent problems certainly warrant the attention of this Court.

But perhaps the most compelling argument for review here is based on the practical consequences of the ruling below, from a circuit that plays a central role in the administration of the copyright laws. As the court of appeals recognized, the fine arts have in recent years exhibited a strong trend toward works that incorporate images from popular culture. This entire post-modern movement has now been placed in jeopardy by a decision blatantly hostile to such an artistic approach.

The Second Circuit's ruling sends an unmistakable message that use of existing images will be viewed as presumptively illegitimate, even where, as here, there is no realistic concern about interference with the legitimate interests of the creators of those images. *See* M. Buskirk, "Appropriation Under the Gun," *Art in America*, at 37 (June 1992) (citing the "ominous implications" of the Second Circuit's ruling for the post-modern movement). In essence, the court below decreed that artists who sell works incorporating images from the culture at large will be treated as if they are in the "business" of commercial appropriation of the work of others unless they can show that the audience will understand their work as a comment, not just on popular culture, but also on a particular prior work. Even then, if those artists sell their works for substantial amounts of money, it is far from clear that the fair-use privilege will be applied.[22]

The predictable result of this decision will be a spate of lawsuits by copyright holders seeking to profit from the fact that images from popular culture have turned up in the works of post-modern artists. These lawsuits will

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[22] We note that, under the current copyright regime, almost any image that exists in popular culture can claim copyright protection. Thus, post-modern artists have no real choice about selecting images that have the potential for producing copyright challenges.

be brought even where, as here, there is no actual commercial injury. Indeed, they will be brought precisely because copyright holders will object to being held up as representatives of "banal" or otherwise undesirable aspects of our culture.

If such claims are sanctioned, the current evolution of fine arts will be severely affected. Copyright holders certainly are not going to grant licenses to artists seeking to use images in this way. *See Fisher v. Dees*, 794 F.2d at 437 ("Parodists will seldom get permission from those whose works are parodied. Self-esteem is seldom strong enough to permit the granting of permission even in exchange for a reasonable fee.") The net result will be suppression of artistic criticism of popular culture—an outcome that utterly defeats the purposes of copyright because it inhibits creativity while in no way furthering the legitimate interests of copyright holders in profiting from their works in the ways that they would ordinarily anticipate.

Indeed, the effects of the decision below will also reach well beyond the fine arts. Many different kinds of creative activity, in many fields, depend on the use of prior works. It is only where such use in fact threatens commercial injury that the copyright laws should come into play. Yet the ruling below sends an ominous message that even in the absence of actual or potential injury, reliance on the defense of fair use may be a risky proposition. This Court should act to remove this threat to the free flow of legitimate ideas and expression.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

Nos. 234, 388, 235—August Term 1991

(Argued October 3, 1991 Decided April 2, 1992)

Docket Nos. 91-7396, 91-7442, 91-7540

ART ROGERS,
Plaintiff-Appellee-Cross-Appellant,

v.

JEFF KOONS; SONNABEND GALLERY, INC.,
Defendants-Appellants-Cross-Appellees.

Before:

CARDAMONE, PIERCE and WALKER
Circuit Judges

Appeal by defendants Jeff Koons and Sonnabend Gallery, Inc. from a judgment dated December 10, 1990 in the United States District Court for the Southern District of New York (Haight, J.) that granted plaintiff Art Rogers summary judgment in his copyright infringement suit, 17 U.S.C. § 101 *et seq.* against appellants. Appellants also appeal from that portion of the district court order requiring appellant Koons to turn over to appellee

his artist proof pursuant to 17 U.S.C. § 503(b). Appellee cross-appeals from the denial of an award of infringing profits under 17 U.S.C. § 504, which the district court reserved for trial.

Affirmed.

CARDAMONE, *Circuit Judge*:

The key to this copyright infringement suit, brought by a plaintiff photographer against a defendant sculptor and the gallery representing him, is defendants' borrowing of plaintiff's expression of a typical American scene—a smiling husband and wife holding a litter of charming puppies. The copying was so deliberate as to suggest that defendants resolved so long as they were significant players in the art business, and the copies they produced bettered the price of the copied work by a thousand to one, their piracy of a less well-known artist's work would escape being sullied by an accusation of plagiarism.

BACKGROUND FACTS

A. *Rogers*

We think it helpful to understanding this appeal to set forth the principals' professional backgrounds. Plaintiff, Art Rogers, a 43-year-old professional artist-photographer, has a studio and home at Point Reyes, California, where he makes his living by creating, exhibiting, publishing and otherwise making use of his rights in his photographic works. Exhibitions of his photographs have been held in California and as far away as Maine, Florida and New York. His work has been described in French ("Le Monde"), British ("The Photo") and numerous American publications, including the Journal of American Photography, Polaroid's Close-Up Magazine and the Popular Photography Annual. Rogers' photographs are part of the permanent collection of the San Francisco Museum of

Modern Art, the Center for Creative Photography at the University of Arizona and Joseph E. Seagrams and Sons in New York City. He has taught photography at the San Francisco Museum of Modern Art.

B. *Creating The Photograph "Puppies"*

In 1980 an acquaintance, Jim Scanlon, commissioned Rogers to photograph his eight new German Shepherd puppies. When Rogers went to his home on September 21, 1980 he decided that taking a picture of the puppies alone would not work successfully, and chose instead to include Scanlon and his wife holding them. Substantial creative effort went into both the composition and production of "Puppies," a black and white photograph. At the photo session, and later in his lab, Rogers drew on his years of artistic development. He selected the light, the location, the bench on which the Scanlons are seated and the arrangement of the small dogs. He also made creative judgments concerning technical matters with his camera and the use of natural light. He prepared a set of "contact sheets," containing 50 different images, from which one was selected.

After the Scanlons purchased their prints for $200, "Puppies" became part of Rogers' catalogue of images available for further use, from which he, like many professional photographers, makes his living. "Puppies" has been used and exhibited a number of times. A signed print of it has been sold to a private collector, and in 1989 it was licensed for use in an anthology called "Dog Days." Rogers also planned to use the picture in a series of hand-tinted prints of his works. In 1984 Rogers had licensed "Puppies", along with other works, to Museum Graphics, a company that produces and sells notecards and postcards with high quality reproductions of photographs by well-respected American photographers including, for example, Ansel Adams. Museum Graphics has produced and distributed the "Puppies" notecard since

1984. The first printing was of 5,000 copies and there has been a second similar size printing.

C. *Koons*

Defendant Jeff Koons is a 37-year-old artist and sculptor residing in New York City. After receiving a Bachelor of Fine Arts degree from Maryland Institute College of Art in 1976, he worked at a number of jobs, principally membership development at the Museum of Modern Art in New York. While pursuing his career as an artist, he also worked until 1984 as a mutual funds salesman, a registered commodities salesman and broker, and a commodities futures broker. In the ten years from 1980 to 1990 Koons has exhibited his works in approximately 100 Group Exhibitions and in eleven one-man shows. His bibliography is extensive. Koons is represented by Sonnabend Gallery, New York, Donald Young Gallery, Chicago, and Galerie Max Hetzler, Cologne, Germany. His works sell at very substantial prices, over $100,000. He is a controversial artist hailed by some as a "modern Michelangelo," while others find his art "truly offensive." A New York Times critic complained that "Koons is pushing the relationship between art and money so far that everyone involved comes out looking slightly absurd."

D. *Creating the Sculpture "String of Puppies"*

After a successful Sonnabend show in 1986, Koons began creating a group of 20 sculptures for a 1988 exhibition at the same gallery that he called the "Banality Show." He works in an art tradition dating back to the beginning of the twentieth century. This tradition defines its efforts as follows: when the artist finishes his work, the meaning of the original object has been extracted and an entirely new meaning set in its place. An example is Andy Warhol's reproduction of multiple images of Campbell's soup cans. Koons' most famous

work in this genre is a stainless steel casting of an inflatable rabbit holding a carrot. During 1986 and 1987 the sculptor traveled widely in Europe looking at materials and workshops where he might fabricate materials for the Banality Show. He decided to use porcelain, mirrors and wood as mediums. Certain European studios were chosen to execute his porcelain works, other studios chosen for the mirror pieces, and the small Demetz Studio, located in the northern hill country town of Ortessi, Italy, was selected to carve the wood sculptures.

Koons acknowledges that the source for "String of Puppies" was a Museum Graphics notecard of "Puppies" which he purchased in a "very commercial, tourist-like card shop" in 1987. After buying the card, he tore off that portion showing Rogers' copyright of "Puppies." Koons saw certain criteria in the notecard that he thought made it a workable source. He believed it to be typical, commonplace and familiar. The notecard was also similar to other images of people holding animals that Koons had collected. Thus, he viewed the picture as part of the mass culture—"resting in the collective sub-consciousness of people regardless of whether the card had actually ever been seen by such people."

Appellant gave his artisans one of Rogers' notecards and told them to copy it. But in order to guide the creation of a three-dimensional sculptural piece from the two-dimensional photograph, Koons communicated extensively with the Demetz Studio. He visited it once a week during the period the piece was being carved by the workers and gave them written instructions. In his "production notes" Koons stressed that he wanted "Puppies" copied faithfully in the sculpture. For example, he told his artisans the "*work must be just like photo*—features of photo must be captured;" later, "*puppies need detail in fur.* Details—Just Like *Photo*!;" other notes instruct the artisans to "*keep man in angle of photo*—mild lean to side & mildly forward—same for woman," to "keep woman's big smile," and to "keep [the sculpture] very,

very realistic;" others state, "*Girl's nose is too small. Please make larger as per photo*;" another reminds the artisans that "The puppies must have variation in fur *as per photo*—not just large area of paint—variation *as per photo*." (emphasis supplied).

To paint the polychromed wood "String of Puppies" sculptures, Koons provided a chart with an enlarged photocopy of "Puppies" in the center; painting directions were noted in the margin with arrows drawn to various areas of the photograph. The chart noted, "Puppies, painted in shades of blue. Variation of light-to-dark *as per photo*. Paint realistic *as per photo*, but in blues." and "Man's hair, white with shades of grey *as per black and white photo*!" (emphasis supplied).

When it was finished, "String of Puppies" was displayed at the Sonnabend Gallery, which opened the Banality Show on November 19, 1988. Three of the four copies made were sold to collectors for a total of $367,000; the fourth or artist's copy was kept by Koons. Defendant Koons' use of "Puppies" to create "String of Puppies" was not authorized by plaintiff. Rogers learned of Koons' unauthorized use of his work through Jim Scanlon, the man who had commissioned Rogers to create "Puppies." A friend of Scanlon's, who was familiar with the photograph, called to tell him that what she took to be a "colorized" version of "Puppies" was on the front page of the calendar section of the May 7, 1989 Sunday *Los Angeles Times*. In fact, as she and Scanlon later learned, the newspaper actually depicted Koons' "String of Puppies" in connection with an article about its exhibition at the Los Angeles Museum of Contemporary Art.

PRIOR PROCEEDINGS

Rogers brought this action against Koons and Sonnabend Gallery on October 11, 1989, alleging copyright infringement and unfair competition under § 43(a) of the Lanham Act and under state law. Both sides advised the

district court at an early stage of the proceedings that, at least as to copyright infringement, disputed factual issues were unlikely and disposition on summary judgment would probably be appropriate. After completion of discovery, both sides moved for that relief on July 5, 1990. Rogers' motion was limited to the copyright infringement claim. Koons and the Sonnabend Gallery sought summary judgment dismissing all counts in plaintiff's complaint.

The district court held oral argument on November 26, 1990. In a December 10, 1990 decision, described more fully below, it found that Koons copied "Puppies" in "String of Puppies" and that this copying was not a fair use. It therefore found infringement. Rogers' motion for an infringing profits award was denied because the trial court believed there were disputed questions of fact concerning their computation. As to Sonnabend Gallery, the district court concluded on February 22, 1991 that the record showed Sonnabend's as well as Koons' liability for infringing profits. On March 27, 1991 it entered a permanent injunction enjoining Koons and Sonnabend Gallery from making, selling, lending or displaying any copies of, or derivative works based on, "Puppies," and, pursuant to 17 U.S.C. § 503, requiring defendants to deliver all infringing articles to plaintiff within 20 days, including the fourth or artist's copy of "String of Puppies."

When defendants failed to comply with the turn-over order, Rogers moved to hold defendant Koons in contempt. The proceedings on that motion revealed that nine days after the injunction was issued, Koons had loaned the fourth copy of "String of Puppies" to a museum in Germany and arranged for its shipment out of the United States. After a hearing on May 8, 1991 the district court held Koons in contempt, directed him to do whatever was necessary to effect the sculpture's return from Germany,

and imposed a daily fine for continued non-compliance to commence eight days later.

On May 28, 1991 we denied Koons' motion to stay the injunction and the contempt penalty pending appeal, but delayed the commencement of the daily fine until June 7, 1991. From the finding of copyright infringement, the granting of a permanent injunction, and the turn-over order appellants Koons and Sonnabend appeal. Rogers cross-appeals from the denial of an award prior to trial for infringing profits. We affirm.

DISCUSSION

I *Ownership of Copyright in an Original Work of Art*

One of the powers given Congress under Art. I, § 8 of the United States Constitution is: "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors, the exclusive Right to their respective Writings and Discoveries." Madison noted that "[T]he utility of this power will scarcely be questioned." The Federalist No. 43 (Madison) at 279. He further observed that copyright for authors was their right under common law. *Id.*; *see* 2 Blackstone, *Commentaries on the Laws of England* 407 (Univ. of Chicago ed. 1979). As a result, Congress enacted a copyright law, 17 U.S.C. § 101 *et seq.* (1976), under which the instant litigation was instituted.

To establish an infringement of a copyright, a plaintiff must show both ownership of a copyright and that defendant copied the protected material without authorization. *See Weissmann v. Freeman*, 868 F.2d 1313, 1320 (2d Cir.), *cert. denied*, 493 U.S. 883 (1989). The Copyright Act makes a certificate of registration from the U.S. Register of Copyrights *prima facie* evidence of the valid ownership of a copyright, *see* 17 U.S.C. § 410(c), though that presumption of ownership may be rebutted, *see Hasbro Bradley, Inc. v. Sparkle Toys, Inc.*, 780 F.2d

189, 192 (2d Cir. 1985). Protection under the copyright statute extends to pictorial works, 17 U.S.C. § 102(a)(5). For more than a century photographs have been held to be copyrightable "writings" under Article I, § 8 of the Constitution. *Burrow-Giles Lithograph Co. v. Sarony*, 111 U.S. 53 (1884) (photograph of Oscar Wilde an original work of art).

Of the several issues before us, the first concerns the originality of "Puppies." Defendants do not challenge plaintiff's ownership of a valid copyright, but assert instead that the portion of Rogers' work allegedly infringed was not an original work of authorship protected under the 1976 Copyright Act. Since the law protects authors' exclusive rights to their works, the cornerstone of that law is that the work protected must be original. *See Feist Publications, Inc. v. Rural Telephone Service Co., Inc.*, 111 S.Ct. 1282, 1287 (1991). Thus, that a whole work is copyrighted does not mean that every element of it is copyrighted; copyright protection extends only to those components of the work that are original to the creator. *Id.* at 1289. But the quantity of originality that need be shown is modest—only a dash of it will do. *Id.* at 1287; 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 1.08[C][1] (1991) (Nimmer).

Elements of originality in a photograph may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved. *See Burrow Giles*, 111 U.S. at 60. 1 Nimmer, § 2.08[E][1]. To the extent that these factors are involved, "Puppies" is the product of plaintiffs' artistic creation. Rogers' inventive efforts in posing the group for the photograph, taking the picture, and printing "Puppies" suffices to meet the original work of art criteria. Thus, in terms of his unique expression of the subject matter captured in the photograph, plaintiff has established valid ownership of a copyright in an original work of art.

II *Unauthorized Copying by Defendant*

Plaintiff next must demonstrate that defendant Koons copied his protected work without authorization. The district court granted summary judgment to Rogers on this issue, finding Koons' sculpture "String of Pupplies" an unauthorized copy of Rogers' photograph. Summary judgment may be an appropriate remedy in copyright infringement suits. *See, e.g., Peter Pan Fabrics, Inc. v. Dan River Mills, Inc.*, 295 F. Supp. 1366, 1369 (S.D.N.Y.), *aff'd*, 415 F.2d 1007 (2d Cir. 1969). Yet, such relief will be denied when the question of substantial similarity is one on which reasonable minds could differ. *See, e.g., Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327, 1329 (9th Cir. 1983).

Here, the trial court found original elements of creative expression in the copyrighted work were copied and that the copying was so blatantly apparent as not to require a trial. We agree that no reasonable juror could find that copying did not occur in this case. First, this case presents the rare scenario where there is direct evidence of copying. Koons admittedly gave a copy of the photograph to the Italian artisans with the explicit instruction that the work be copied. Moreover, the importance of copying the very details of the photograph that embodied plaintiff's original contribution—the poses, the shading, the expressions—was stressed by Koons throughout the creation of the sculpture. His instructions invariably implored that the creation must be designed "as per photo." This undisputed direct evidence of copying is sufficient to support the district court's granting of summary judgment.

Further, even were such direct evidence of copying unavailable, the district court's decision could be upheld in this case on the basis that defendant Koons' access to the copyrighted work is conceded, and the accused work is so substantially similar to the copyrighted work that reasonable jurors could not differ on this issue. *See*

Warner Brothers, Inc. v. American Broadcasting Cos., Inc., 654 F.2d 204, 207 (2d Cir. 1981).

Substantial similiarity does not require literally identical copying of every detail. *See* 3 Nimmer, § 13.03[A]. *See also Comptone Company Ltd. v. Rayex Corp.*, 251 F.2d 487, 488 (2d Cir. 1958). Such similarity is determined by the ordinary observer test: the inquiry is "whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work." *Ideal Toy Corp. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966). Or, stated another way, whether "the ordinary observer, unless he set out to detect the disparities, would be disposed to overlook them, and regard their aesthetic appeal as the same." *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960). Thus, Koons' allegation that a trial judge uneducated in art is not an appropriate decision-maker misses the mark; the decision-maker, whether it be a judge or a jury, need not have any special skills other than to be a reasonable and average lay person.

We recognize that ideas, concepts, and the like found in the common domain are the inheritance of everyone. What is protected is the original or unique way that an author expresses those ideas, concepts, principles or processes. Hence, in looking at these two works of art to determine whether they are substantially similar, focus must be on the similarity of the *expression* of an idea or fact, not on the similarity of the facts, ideas or concepts themselves. *See Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905, 912 (2d Cir. 1980). It is not therefore the idea of a couple with eight small puppies seated on a bench that is protected, but rather Roger's *expression* of this idea—as caught in the placement, in the particular light, and in the expressions of the subjects—that gives the photograph its charming and unique character, that is to say, makes it original and copyrightable.

Thus, had appellant simply used the *idea* presented by the photo, there would not have been infringing copying. But here Koons used the identical expression of the idea that Rogers created; the composition, the poses, and the expressions were all incorporated into the sculpture to the extent that, under the ordinary observer test, we conclude that no reasonable jury could have differed on the issue of substantial similarity. For this reason, the district court properly held that Koons "copied" the original.

Moreover, no copier may defend the act of plagiarism by pointing out how much of the copy he has not pirated. *See Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir.) (L. Hand, J.), *cert. denied*, 298 U.S. 669 (1936). Thus, where substantial similarity is found, small changes here and there made by the copier are unavailing. It is only where the points of dissimilarity exceed those that are similar and those similar are—when compared to the original work—of small import quantitatively or qualitatively that a finding of no infringement is appropriate. *See* 3 Nimmer § 13.03[B][1][a]. This is not the case here. Koons' additions, such as the flowers in the hair of the couple and the bulbous noses of the puppies, are insufficient to raise a genuine issue of material fact with regard to copying in light of the overwhelming similarity to the protected expression of the original work.

Because of Koons' extensive use of the same expression of the idea that Rogers' created, it was properly held that he "copied" the protected features of the original. No genuine issue of material fact exists with respect to this finding; "String of Puppies' was copied from the photograph "Puppies" based either on the direct evidence of copying or on proof of access and substantial similarity. In light of this summary judgment was properly granted on this issue.

III *The Fair Use Doctrine*

Defendant Koons further defends his use of Rogers' work "Puppies" to craft "String of Puppies" under a claim of a privilege of "fair use." This equitable doctrine permits other people to use copyrighted material without the owner's consent in a reasonable manner for certain purposes. Codified in § 107 of the 1976 Copyright Act, it is of ancient lineage. Section 107 states that an original work copied for purposes such as criticism or comment may not constitute infringement, but instead may be a fair use. The section provides an illustrative—but not exhaustive—list of factors for determining when a use is "fair." These factors include (1) the purpose and character of the use, (2) the nature of the copyrighted work, (3) the amount and substantiality of the work used, and (4) the effect of the use on the market value of the original. 17 U.S.C. § 107.

The fact that the test envisioned by the Act is dependent on the circumstances of each case, *see* 3 Nimmer, § 13.05[A], might suggest summary judgment is unavailable when fair use is the issue, but such relief may be granted when appropriate. *See e.g., Stewart v. Abend*, 495 U.S. 207 (1990) (summary judgment granted upon finding of no fair use). The trial court found no genuine issues of fact present regarding the fair use exception and granted summary judgment to plaintiff on this issue also. We proceed therefore to analyze the fair use factors in the circumstances of the case at hand. Our examination of these factors leads us to conclude that the district court properly granted summary judgment in favor of plaintiff.

1. *Purpose and Character of the Use*

The first factor, purpose and character of the use, asks whether the original was copied in good faith to benefit the public or primarily for the commercial interests of the infringer. *See MCA, Inc. v. Wilson*, 677 F.2d 180, 182

(2d Cir. 1981). Knowing exploitation of a copyrighted work for personal gain militates against a finding of fair use. And—because it is an equitable doctrine—wrongful denial of exploitative conduct towards the work of another may bar an otherwise legitimate fair use claim. *See* 3 Nimmer, § 13.05[A][1]. Relevant to this issue is Koons' conduct, especially his action in tearing the copyright mark off of a Rogers notecard prior to sending it to the Italian artisans. This action suggests bad faith in defendant's use of plaintiff's work, and militates against a finding of fair use.

The Supreme Court has held that copies made for commercial or profit-making purposes are presumptively unfair. *See Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 449 (1984). The Court explained in a subsequent case that the "crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price." *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 562 (1985). We have stated that, though it is a significant factor, whether the profit element of the fair use calculus affects the ultimate determination of whether there is a fair use depends on the totality of the factors considered; it is not itself controlling. *See Maxtone-Graham v. Burtchaell*, 803 F.2d 1253, 1262 (2d Cir. 1986), *cert. denied*, 481 U.S. 1059 (1987). Thus, while we note that Koons' substantial profit from his intentionally exploitive use of Rogers' work also militates against the finding of fair use, we turn next to consider his contention that the primary purpose of the use was for social comment.

Parody or Satire as Fair Use: The Act expressly provides that comment on or criticism of a copyrighted work may be a valid use under the fair use doctrine. We must analyze therefore whether "String of Puppies" is properly considered a comment on or criticism of the photograph

"Puppies." Koons argues that his sculpture is a satire or parody of society at large. He insists that "String of Puppies" is a fair social criticism and asserts to support that proposition that he belongs to the school of American artists who believe the mass production of commodities and media images has caused a deterioration in the quality of society, and this artistic tradition of which he is a member proposes through incorporating these images into works of art to comment critically both on the incorporated object and the political and economic system that created it. These themes, Koons states, draw upon the artistic movements of Cubism and Dadaism, with particular influence attributed to Marcel Duchamp, who in 1913 became the first to incorporate manufactured objects (readymades) into a work of art, directly influencing Koons' work and the work of other contemporary American artists. We accept this definition of the objective of this group of American artists.

To analyze Koons' parody defense, we must first define it. Parody or satire, as we understand it, is when one artist, for comic effect or social commentary, closely imitates the style of another artist and in so doing creates a new art work that makes ridiculous the style and expression of the original. Under our cases parody and satire are valued forms of criticism, encouraged because this sort of criticism itself fosters the creativity protected by the copyright law. *See Warner Bros., Inc. v. American Broadcasting Cos., Inc.*, 720 F.2d 231, 242 (2d Cir. 1983). We have consistently held that a parody entitles its creator under the fair use doctrine to more extensive use of the copied work than is ordinarily allowed under the substantial similarity test. *See Elsmere Music, Inc. v. National Broadcasting Co.*, 623 F.2d 252, 253 (2d Cir. 1980) (per curiam).

Hence, it must first be determined whether "String of Puppies" is a parody of Rogers' work for purposes of the fair use doctrine. We agree with the district court that it

is not. It is the rule in this Circuit that though the satire need not be only of the copied work and may, as appellants urge of "String of Puppies," also be a parody of modern society, the copied work must be, at least in part, an object of the parody, otherwise there would be no need to conjure up the original work. *See MCA, Inc. v. Wilson*, 677 F.2d at 185; 3 Nimmer, § 13.05[C] n. 60.9.

We think this is a necessary rule, as were it otherwise there would be no real limitation on the copier's use of another's copyrighted work to make a statement on some aspect of society at large. If an infringement of copyrightable expression could be justified as fair use solely on the basis of the infringer's claim to a higher or different artistic use—without insuring public awareness of the original work—there would be no practicable boundary to the fair use defense. Koons' claim that his infringement of Rogers' work is fair use solely because he is acting within an artistic tradition of commenting upon the commonplace thus cannot be accepted. The rule's function is to insure that credit is given where credit is due. By requiring that the copied work be an object of the parody, we merely insist that the audience be aware that underlying the parody there is an original and separate expression, attributable to a different artist. This awareness may come from the fact that the copied work is publicly known or because its existence is in some manner acknowledged by the parodist in connection with the parody. Of course, while our view of this matter does not necessarily prevent Koons' expression, although it may, it does recognize that any such exploitation must at least entail "paying the customary price." *Harper & Row Publishers, Inc.*, 471 U.S. at 562.

The problem in the instant case is that even given that "String of Puppies" is a satirical critique of our materialistic society, it is difficult to discern any parody of the photograph "Puppies" itself. We conclude therefore that this first factor of the fair use doctrine cuts against a

finding of fair use. The circumstances of this case indicates that Koons' copying of the photograph "Puppies" was done in bad faith, primarily for profit-making motives, and did not constitute a parody of the original work.

2. *Nature of the Copyrighted Work*

The next fair use factor asks what is the nature of the work that has been copied. Where the original work is factual rather than fictional the scope of fair use is broader. *See New Era Publications, Int'l. v. Carol Publishing Group*, 904 F.2d 152, 157 (2d Cir.), *cert. denied*, 111 S. Ct. 297 (1990). Whether the original is creative, imaginative, or represents an investment of time in anticipation of a financial return also should be considered. *MCA, Inc. v. Wilson*, 677 F.2d at 182. Here "Puppies" was a published work of art. As an original expression it has more in common with fiction than with works based on facts, such as, for example, biographies or telephone directories. Since "Puppies" was creative and imaginative and Rogers, who makes his living as a photographer, hopes to gain a financial return for his efforts with this photograph, this factor militates against a finding of fair use.

3. *Amount and Substantiality of Work Used*

Where the amount of copying exceeds permissible levels, summary judgment has been upheld. *Walt Disney Productions v. Air Pirates*, 581 F.2d 751, 758 (9th Cir. 1978), *cert. denied*, 439 U.S. 1132 (1979). To a large degree, this factor involves the same analysis as that used when determining if the copy is substantially similar to the original. Sometimes wholesale copying may be permitted, while in other cases taking even a small percentage of the original work has been held unfair use. *See Maxtone-Graham*, 803 F.2d at 1263. "[W]hat is relevant is the amount and substantiality of the copyrighted *expression* that has been used, not the *factual content* of the material in the copyrighted works." *Salinger v. Random*

House, Inc., 811 F.2d 90, 97 (2d Cir.) (emphasis in original), *reh'g denied*, 818 F.2d 252, *cert. denied*, 484 U.S. 890 (1987). It is not fair use when more of the original is copied than necessary. Even more critical than the quantity is the qualitative degree of the copying: what degree of the essence of the original is copied in relation to its whole. *Id.* at 98; *see also New Era Publications Int'l*, 904 F.2d at 159.

Appellants claim that under a parody defense their use of Rogers' work did not exceed the level permitted under the fair use doctrine. As discussed previously, this Circuit has traditionally afforded parodists significant leeway with respect to the extent and nature of their copying. *See Elsmere*, 623 F.2d at 253, n.1; *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541, 545 (2d Cir.), *cert. denied*, 379 U.S. 822 (1964). Yet, even under such a defense there are limitations on what constitutes fair use. *See MCA v. Wilson*, 677 F.2d at 185. Here, the essence of Rogers' photograph was copied nearly *in toto*, much more than would have been necessary even if the sculpture had been a parody of plaintiff's work. In short, it is not really the parody flag that appellants are sailing under, but rather the flag of piracy. Moreover, because we have already determined that "String of Puppies" is not a parody of Rogers' work, appellants cannot avail themselves of this heightened tolerance under a parody defense.

Nor does *Sony Corp. of America*, 464 U.S. at 449-50, bear the weight that appellants place on it for the proposition that even 100 percent copying does not preclude a fair use finding. Although correct as a general statement, it applied in *Sony* to a narrow set of circumstances. Sony's copying equipment (Betamax VCRs) was used by members of the public to record television programs—the copyright of which was owned by plaintiffs. The question was whether Sony's selling of the copying equipment violated plaintiffs' rights under the Copyright Act.

The Supreme Court said "no" because "time-shifting" for those watching a television program enlarges the viewing audience, and does not impair plaintiffs' commercial right in the value of the copyright. Hence, no basis existed under the Act upon which plaintiffs could hold Sony liable for selling VCR's to the general public. *Id.* at 421.

Those are not the facts found here. Instead, Koons' copying of Rogers' work was the essence of the photograph, and designedly done as the notes to the Italian artisans conclusively reveal. Koons went well beyond the factual subject matter of the photograph to incorporate the very expression of the work created by Rogers. We find that no reasonable jury could conclude that Koons did not exceed a permissible level of copying under the fair use doctrine.

4. *Effect of the Use on the Market Value of the Original*

The fourth factor looks at the effect of the use on the market value of the original. The Supreme Court in *Stewart*, 495 U.S. 207, stated that the fourth factor "is the 'most important, and indeed, central fair use factor.'" *Id.* at 238 (quoting 3 Nimmer § 13.05[A]); *see also Harper & Row*, 471 U.S. at 566. Under this factor a balance must be struck between the benefit gained by the copyright owner when the copying is found an unfair use and the benefit gained by the public when the use is held to be fair. The less adverse impact on the owner, the less public benefit need be shown to sustain non-commercial fair use. It is plain that where a use has no demonstrable impact on a copyright owners' potential market, the use need not be prohibited to protect the artist's incentive to pursue his inventive skills. Yet where the use is intended for commercial gain some meaningful likelihood of future harm is presumed. *See Sony Corp. of America*, 464 U.S. at 451.

A critical inquiry under this factor then is whether defendants Koons and Sonnabend planned to profit from their exploitation of "Puppies" without paying Rogers for their use of his photo—that is, whether Koons' work is primarily commercial in nature. We have already concluded that it is. In this case, of course, the copy was in a different medium than the original: one was a three-dimensional piece of sculpture, and the other a two-dimensional black and white photo. But the owner of a copyright with respect to this market-factor need only demonstrate that if the unauthorized use becomes "widespread" it would prejudice his potential market for his work. *See id.; Harper & Row*, 471 U.S. at 568. The reason for this rule relates to a central concern of copyright law that unfair copying undercuts demand for the original work and, as an inevitable consequence, chills creation of such works. Hence the inquiry considers not only harm to the market for the original photograph, but also harm to the market for derivative works. It is obviously not implausible that another artist, who would be willing to purchase the rights from Rogers, would want to produce a sculpture like Rogers' photo and, with Koons' work extant, such market is reduced. Similarly, defendants could take and sell photos of "String of Puppies," which would prejudice Rogers' potential market for the sale of the "Puppies" notecards, in addition to any other derivative use he might plan.

Further, in discussing this fourth factor, the leading scholar in this area of the law uses an example that closely parallels the facts of the present case and demonstrates the irrelevance of copying in a different medium when analyzing this factor: a movie adaptation is made of a book. Even though the movie may boost book sales, it is an unfair use because of the effect on the potential sale of adaptation rights. 3 Nimmer, § 13.05[B]. The function of demand for each original work of art is a relevant facet in this factor's analysis; that is, fair use permits lyrics or music to be copied in a literary magazine,

but where the same material is published in a song sheet magazine, purchased for playing and not simply for reading, it is an unfair use. *Id.*

Here there is simply nothing in the record to support a view that Koons produced "String of Puppies" for anything other than sale as high-priced art. Hence, the likelihood of future harm to Rogers' photograph is presumed, and plaintiff's market for his work has been prejudiced.

IV *Infringing Profits*

The next issue concerns Rogers' claim for infringing profits in the amount of $367,000. Under 17 U.S.C. § 504(b) a copyright owner is entitled to recover actual damages suffered as a result of the infringement as well as apportioned profits. The section states: "In establishing the infringer's profits, the copyright owner is required to present proof only of the infringer's gross revenue, and the infringer is required to prove his or her deductible expenses and the elements of profit attributable to factors other than the copyrighted work." Alternatively, in place of actual damages and apportioned profits, a copyright owner may elect to recover an award of statutory damages. *See* 17 U.S.C. § 504(c).

In Rogers' cross-appeal he asserts, in response to defendants' argument that we lack appellate jurisdiction over this issue, that jurisdiction exists on two independent bases. He further contends that there are no issues of fact and that the matter should be remanded simply to enter an award in his favor. Although we agree with Rogers that jurisdiction over this aspect of the judgment appealed from exists, we are unable to grant the award he seeks.

The district court stated that deposition and documentary evidence regarding the deductible expenses referred to in § 504(b) are present in the record. We are satisfied that defendants have incurred deductible expenses in

some amount and that they should have an opportunity to prove them as an offset to plaintiff's evidence of infringing damages. Further, the amount of actual damages incurred by Rogers, as well as the proper apportionment of Koons' profits between Rogers and Koons, remain to be determined on remand. With respect to the calculation of actual damages, "the primary measure of recovery is the extent to which the market value of the copyrighted work at the time of the infringement has been injured or destroyed by the infringement." *Fitzgerald Pub. Co., Inc. v. Baylor Pub. Co., Inc.*, 807 F.2d 1110, 1118 (2d Cir. 1986). While we leave the ascertainment of damages to the district court, under the circumstances of this case, we think that a reasonable license fee for the use of "Puppies" best approximates the market injury sustained by Rogers as a result of Koons' misappropriation. *See Deltak, Inc. v. Advanced Systems, Inc.*, 767 F.2d 357, 360-61 (7th Cir. 1985) ("The value of the infringer's use is a permissible basis for estimating actual damages."); *Sid & Marty Kroft Television Productions, Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1174 (9th Cir. 1977) (same).

On the subject of apportioning profits, the copyright law requires that Koons have the opportunity to establish those "elements of profit attributable to factors other than the copyrighted work." 17 U.S.C. § 504(b). These "elements" may include Koons' own notoriety and his related ability to command high prices for his work. *See Sheldon v. Metro-Goldwyn Corp.*, 309 U.S. 390, 407-09 (1940) (considering "the drawing power of the 'motion picture stars' . . . the artistic conceptions . . . and . . . the expert supervision and direction of the various processes which made possible the composite result"); *Frank Music Corp. v. Metro-Goldwyn-Mayer Inc.*, 886 F.2d 1545, 1549 (9th Cir. 1989), *cert. denied*, 494 U.S. 1017 (1990) ("Where a defendant alters infringing material to suit its own unique purposes, those alterations and the crea-

tivity behind them should be taken into account in apportioning the profits of the infringing work."); *Abend v. MCA, Inc.*, 863 F.2d 1465, 1478, *aff'd sub nom. Stewart v. Abend*, 495 U.S. 207 (1990) (considering outstanding performances and brilliant direction); *ABKCO Music, Inc. v. Harrisongs Music*, 508 F. Supp. 798, 801 (S.D.N.Y. 1981), *modified*, 722 F.2d 988 (2d Cir. 1983) (considering "international 'name'" of infringing recording artist). *See also* 3 Nimmer § 14.03[C]. To the extent that Koons is able to prove that the profits at issue derive solely from his own position in the art world, he should be allowed to retain them.

Finally, we note that Rogers remains at liberty to elect statutory damages in lieu of an award of actual damages and apportioned profits. *See* 17 U.S.C. § 504(c). In fact, given Koons' wilful and egregious behavior, we think Rogers may be a good candidate for enhanced statutory damages pursuant to 17 U.S.C. § 504(c)(2). *See Fitzgerald Pub. Co.*, 807 F.2d at 1115. Of course, that determination remains for the district court to make in the first instance.

The case must be remanded therefore for the district court to determine the amount of the award, a matter which it had reserved to itself prior to the institution of this appeal.

V *The Turn-Over Order*

Finally, the turn-over order of the artist's copy is an equitable remedy issued under the broad powers vested in a trial judge under 17 U.S.C. § 503(b) (court may order destruction or other reasonable disposition of infringing copies). In this case, after Judge Haight issued his turn-over order, Koons arranged to ship the fourth or artist's copy of "String of Puppies" from the United States to Germany. We see no abuse of the district court's discretion in directing turn-over and, under the

circumstances, the contempt order for the direct violation of the turn-over order was entirely proper.

CONCLUSION

Accordingly, the judgment of the district court is affirmed in all respects.

APPENDIX B

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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89 Civ. 6707 (CSH)

ART ROGERS,

—against— *Plaintiff,*

JEFF KOONS and SONNABEND GALLERY, INC.,
Defendants.

MEMORANDUM OPINION AND ORDER

HAIGHT, *District Judge*:

Plaintiff, a professional photographer, brings this action against defendants, a sculptor and an art gallery, for copyright infringement under the Copyright Act, Lanhan Act violations, and unfair competition under the laws of New York and California. Plaintiff moves under Rule 56, Fed.R.Civ.P., for summary judgment on his first cause of action for copyright infringement. Defendants cross-move for summary judgment dismissing the complaint.

Background

The facts are largely undisputed. Plaintiff Art Rogers is a professional photographer resident in California. In 1980 Jim Scanlon, another California resident familiar with Rogers' work, commissioned Rogers to make a photographic portrait of the Scanlons' new litter of eight German Shepherd puppies. Rogers went to the Scanlon home. Rather than attempting to pose the puppies alone, he included Scanlon and his wife Mary, who were photographed sitting on a bench holding the puppies. Rogers succeeded in getting two adults and eight puppies to hold still long

enough to produce a charming photograph which Rogers named "Puppies." "Puppies" was published in Rogers' photography column in a local newspaper in 1980. The photograph was exhibited, along with other works by Rogers, at the San Francisco Museum of Modern Art in 1982. In 1984 Rogers licensed "Puppies" along with other works to Museum Graphics, a company that produces and sells notecards and postcards with high quality reproductions of photographs by American photographers, including Ansel Adams. Museum Graphics has produced an distributed the "Puppies" notecard since 1984. A signed print of "Puppies" has been sold to a private collector. In 1989 Rogers licensed the photograph for use in an anthology called "Dog Days." Rogers has stated in an affidavit that he plans to use "Puppies" in a series of hand tinted prints of his works.

Defendant Jeff Koons is a well-known American artist and sculptor resident in New York whose works are exhibited at galleries and museums in the United States and elsewhere and sold to the public. Defendant Sonnabend Gallery represents Koons and serves as his agent in connection with the display and sale of his works. In October 1986 Koons began the process of creating sculptures for what he eventually termed his "Banality Show." His work extended over two years. The exhibition opened at Sonnabend Gallery on November 19, 1988. The exhibition consisted of 20 sculptural works. In Koons' perception, "the subject for the show would be Banality but the message would be a spiritual one. And while being uplifting, the also work would be [sic] critical commentary on conspicuous consumption, greed, and self indulgence." Defendants' Main Brief at 6. All the works were sculptures in various media, including several in "polychromed wood," which is wood painted different colors with oil paint. Each work was produced in an "edition" of three, so that three copies were available for sale to the public. An "artist's proof" of each sculpture was also produced for Koons which he could sell later if he wished.

During the fall and winter of 1986 and throughout 1987 Koons collected material for possible sculptures. He then located and contracted with workshops that could craft the desired materials in the fashion that Koons desired.

At the end of 1987 or in 1988 Koons purchased at least two Museum Graphics notecards displaying Rogers' "Puppies" photograph. These cards were imprinted with Rogers' copyright, although the photograph had not yet been registered. Koons decided to use the photograph for one of the sculptures to be exhibited in the Banality Show. He tore off that portion of the note card showing the copyright notice and sent the photograph to the Demetz Arts Studio in Italy, with instructions to make a polychromed wood sculptural version of the photograph, a work that Koons instructed Demetz "must be just like photo." Ex 15 to Koons deposition (notes Koons furnished to Demetz in connection with producing the sculpture). Koons continued to communicate with Demetz, reiterating that the features of the humans and the puppies be reproduced "as per photo." Ex. 16. As to the painting of the sculpture, Koons gave Demetz a chart with an enlarged photocopy of "Puppies" in the center, and on which he noted painting directions in the margin with arrows drawn to various areas of the photograph. Koons instructed Demetz to paint the puppies in shades of "blue," with "variation of light-to-dark as per photo." The man's hair was to be "white with shades of grey as per black and white photo.") Ex. 14.

The end result was a polychromed wood sculpture 42 inches by 62 inches by 37 inches (not including the base which is 32 inches by 67 by 31 inches). Koons called the sculpture "String of Puppies."

Following the display of "String of Puppies" at the Sonnabend Gallery in December 1988, Koons sold the edition of three sculptures to collectors for a total of

$367,000. Two were sold for the price stated by the Gallery of $125,000. The third buyer paid $117,000. Koons retains a fourth "String of Puppies" sculpture at his storage facility.

Rogers learned of the sculpture through Scanlon. A friend of Scanlon's familiar with the notecard called Scanlon and said that the photograph "Puppies" was on the front page of the calendar section of the Sunday Los Angeles Times, but had been "colorized." Scanlon, having obtained and read the article, realized that it was not a tinted version of the photograph "Puppies," but rather was a photograph of Koons' sculpture "String of Puppies," then on exhibition at the Los Angeles Museum of Contemporary Art. Scanlon told Rogers about it.

Rogers registered his photograph "Puppies" with the United States Copyright Office, obtaining registration number VA 352/001. The effective date of the registration is July 6, 1989. The certificate recites a date of first publication in the United States of November 20, 1980.

Rogers filed this action against Koons and Sonnabend Gallery on October 11, 1989.

It is common ground that Koons did not inform Rogers of his intended use of the photograph, and that Rogers had no knowledge of that use until Scanlon informed him.

Rogers now moves for summary judgment on the first cause of action in the complaint, for copyright infringement. Defendants cross-move for summary judgment dismissing all causes of action.

Discussion

Koons concedes, as he must, that he "used" Rogers' photograph "Puppies" as "source material" for his sculpture "String of Puppies." Koons prefers to avoid the verb "copied." Semantics do not decide the issue, which

is whether or not Koons' conduct constitutes copyright infringement.

Koons says it does not for two principal reasons. First, he argues that Rogers' copyright protection "is strictly limited to the work *as a photograph*." Main Brief at 21 fn. (emphasis added). At oral argument, Koons counsel carried that argument to its logical conclusion and contended that any sculptor could "use" or "copy" any copyrighted photograph without incurring liability as an infringer. Secondly, Koons relies upon the doctrine of fair use. I discuss these contentions in turn.

Use

Koons' main contention under this heading is that the use he made of the Rogers photograph related only to non-copyrightable elements. Koons relies upon the familiar rule that copyright protection extends only to original acts of expression, so that purely factual information is in the public domain. *See, e.g. Hoeling v. Universal City Studios, Inc.*, 618 F.2d 972, 979 (2d Cir. 1980).

That rule has no meaningful application here. Koons does not articulate what non-protectible factual information he regards himself as having used. It is of course the fact that Mr. and Mrs. Scanlon's German Shepherd produced a litter of eight puppies; that the Scanlons thought the puppies were cute; and that they asked Rogers to photograph them. But the manner in which Rogers arranged his subjects and carried out his photographer's art constitutes a protectible original act of expression, as the certificate issued by the Copyright Office reflects.

Koons' reproduction of the Rogers photograph in sculpture form does not preclude a finding of copyright infringement. The Copyright Act, 17 U.S.C. § 106, confers upon the copyright owner "the exclusive rights to do

and to authorize," *inter alia*, the preparation of "derivative works based upon the copyrighted work." § 106(2). The statute defines a "derivative work" as a work "based upon one or more preexisting works, such as [an] . . . art reproduction, . . . or any other form in which a work may be recast, transformed, or adapted." §101. Under the plain wording of the statute, Koons' sculpture is a derivative work based upon Rogers' photograph; and Rogers as copyright owner had the exclusive right to authorize derivative work. It is well settled that a photographer's originality in photographic expression is entitled to full copyright protection. *See Burrow-Giles Lithographic Co. v. Sarony*, 111 U.S. 53, 55 (1884).

Koons' effort to limit that protection to the photograph "as a photograph" runs counter to caselaw. In copyright law the medium is not the message, and a change in medium does not preclude infringement. That has long been the rule of this Court and the Second Circuit. In *Falk v. T.P. Howell & Co.*, 37 Fed. 202 (S.D.N.Y. 1988), defendant, a chair manufacturer, copied plaintiff's copyrighted photograph "and stamped a raised figure, like the picture, on the leather of which the bottoms and backs of chairs are made." Judge Coxe cited *Burrow-Giles Co. v. Sarony*, *supra*, for the proposition that a photograph may be the subject of a copy right, and then said:

> The only question is, do the defendants infringe? That their design is copied directly from the copyrighted photograph is not denied, but it is urged that infringement is avoided, because it is larger than the photograph, and is stamped on leather, and is intended for the bottom or back of a chair. It is thought that this proposition cannot be maintained. Differences which relate merely to size and material are not important.

The Second Circuit cited that language with approval in *King Features Syndicate v. Fleischer*, 299 Fed. 533 (2d Cir. 1924), where the defendant copied plaintiff's

cartoon character for the manufacture of a toy. The court of appeals said generally at 535:

> We do not think it avoids the infringement of the copyright to take the substance or idea, and produce it through a different medium, and picturing in shape and details insufficient imitation to make a true copy of the character thought of by the appellant's employee. Doing this is omitting the work of the artisan, but appropriating the genius of the artist.

After quoting the indicated language from *Falk*, the court of appeals then observed at 536:

> A piece of statuary may be infringed by the picture of the statuary for the Copyright Act secured to the author the original and natural rights and it is the intendment of the law of copyrights that they shall have a liberal construction in order to give effect to what may be consideerd as an inherent right of the author in his work.[1]

The Second Circuit reached the same result without discussion in *Fleischer Studios, Inc. v. Ralph A. Freundlich, Inc.*, 73 F.2d 726 (2d Cir. 1934), where the defendant manufactured dolls copying the plaintiff's copyrighted book of cartoons.

These cases are closely analogous to the case at bar. Three-dimensional toys or dolls copied from one-dimensional cartoons are the functional equivalents of a three-dimensional sculpture copied from a single-dimensional photograph. Such cases are consistent with the general principle stated in 1 M. and D. Nimmer, *Nimmer on Copyright*, (1989) § 2.08(E) at 2-123 to 2-124, where the authors state that it is

---

[1] The case at bar presents the converse proposition. If a picture of a piece of statuary may infringe the sculptor's copyright, so may sculpture infringe a photographer's copyright.

> fundamental that copyright in a work protects against unauthorized copying not only in the original medium in which the work was produced, but also in any one medium as well. . . . The fact that a work in one medium has been copied from a work in another medium does not render it any less a "copy".

By way of contrast, Koons cites no authority for his blanket proposition that a sculpture cannot in law infringe a copyrighted photograph. That proposition seems to me contrary to the Copyright Act and these cases construing the statute, and I reject it.

Koons argues that Rogers must show substantial similarity between the photograph and the sculpture to sustain a claim of infringement, and that the differences in size, texture and color preclude such a finding. This is really the discredited "substitute medium" argument in a different form. Rogers says that where direct copying is conceded, substantial similarity drops out of the analysis. He cites *Illinois Bell Telephone v. Haines & Co., Inc.* 905 F.2d 1081, 1086 (7th Cir. 1990) ("To satisfy the copying element of infringement, direct evidence of copying will suffice. . . . Establishing substantial similarity is necessary only when direct evidence of copying is unavailable"), and *Rural Telephone Service Company, Inc. v. Feist Publications, Inc.*, 663 F. Supp. 214, 218 (D.Kan. 1987) ("The 'substantial similarity' test is used when there is no direct evidence of copying."). For that proposition the district court in *Rural Telephone* cited *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905, 911-12 (2d Cir. 1980). I do not find that particular rule clearly stated in *Durham Industries*, but the case does demonstrate that the present test of substantial similarity in the Second Circuit is "whether an average lay observer would recognize the alleged copy as having been appropriated from the copyrighted work." *See* discussion at 630 F.2d at 911-12 (*citing and quoting Ideal Toy Co. v. Fab-Lu Ltd.*, 360 F.2d 1021, 1022 (2d Cir. 1966)).

There is no question in the case at bar that "an average lay observer" would recognize the sculpture "String of Puppies" as "having been appropriated from" the photograph "Puppies." Questions of size and color aside, the sculpture is as exact a copy of the photograph as Koons' hired artisans could fashion, which is precisely what Koons told them to do. Indeed, Scanlon's friend, having observed a newspaper picture of the sculpture, assumed that it was Rogers' photograph, having been "colorized."

Koons' copying of Rogers' photograph constitutes copyright infringement, unless Koons' conduct may be characterized as "fair use."

Fair Use

Koons asserts that even his use of Rogers' photograph constituted unauthorized copying, it is a fair use and therefore not infringing.

The fair use doctrine, which is incorporated into the 1976 Copyright Act, has been considered in three recent Supreme Court decisions: *Stewart v. Abend*, 110 S.Ct. 1750 (1990); *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 529 (1985); and *Sony Corp. of America v. Universal Studios, Inc.*, 464 U.S. 417 (1984). The fair use doctrine evolved in response to the rigid and inflexible common law rule that the author's property in his intellectual creation was absolute until he voluntarily parted with it. *Stewart* at 1768. The doctrine is an "equitable rule of reason", *Sony* at 448, which "permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster." *Stewart* at 1768 (*citing and quoting Iowa State University Research Foundation, Inc. v. American Broadcasting Companies*, 621 F.2d 57, 60 (2d Cir. 1980)).

17 U.S.C. § 107 provides "that fair use of a copyrighted work . . . is not an infringement of copyright." The stat-

ute attempts no generally applicable definition of fair use, since the doctrine, an equitable rule of reason, is fact-oriented. But Congress did provide in § 107 examples of fair use, and factors to be considered in determining whether a particular case falls within the doctrine. The examples are copying "for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research." The four non-exclusive factors the courts must consider in determining whether an unauthorized use is not infringing are:

> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
>
> (2) the nature of the copyrighted work;
>
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
>
> (4) the effect of the use upon the potential market for or value of the copyrighted work.

Koons' sculpture does not fall within any statutory examples. There was a faint suggestion in his argument that the sculpture, together with the other works in the "Banality Show, were intended to comment satirically upon contemporary values. But I construe the words "criticism" and "comment" as used in § 107 to refer to such usage specifically addressed to the copyrighted work. Koons' sculpture does not criticize or comment upon Rogers' photograph. It simply appropriates it.

Turning from the statutory examples to § 107's four factors, the first involves consideration of whether Koons' use of the Rogers photograph "is of a commercial nature or is for non-profit educational purposes. . ." Clearly Koons' sculpture is not for "non-profit educational purposes." But I do not think Congress intended that phrase

to embrace all non-commercial use. Use of a copyrighted work by a church, synagogue or mosque for purposes of spiritual inspiration would not, I should think, be regarded as use "of a commercial nature." However, the Koons sculpture does not fall in that category either; and, notwithstanding its unquestioned status as a work of art, the sculpture is not unsullied by considerations of commerce. Koons actively markets his sculptures, by displaying them at galleries and through published advertisements, and they bring considerable sums from the public, as the sale of the "String of Puppies" sculptures indicates. In *Stewart v. Abend* the infringing use was a motion picture based upon a copyrighted story. The re-release of the motion picture earned the defendants $12 million. The Ninth Circuit rejected defendants' "bold proposition that a work's popularity may make its value educational rather than commercial. Clearly, the defendants' 'use is of a commercial nature.'" *Abend v. MCA, Inc.*, 863 F.2d 1465, 1481 (2d Cir. 1988). The Supreme Court approved that conclusion at 110 S.Ct. 1768:

> [Defendants] asserted before the Court of Appeals that their use was educational rather than commercial. The Court of Appeals found nothing in the record to support this assertion, nor do we.

In the case at bar, given the plain wording of the statute and this recent construction, I conclude that Koons' use of the Rogers photograph was of a commercial nature.

As to the second factor, the Supreme Court in *Stewart* approved the observation of the Ninth Circuit that "[a] use is less likely to be deemed fair when the copyrighted work is a creative product, 863 F.2d at 1481, adding: "In general, fair use is more likely to be found in factual works than that in fictional works." 110 S. Ct. at 1769. Rogers' photograph is a creative work, more closely akin to fiction.

The third factor considers the amount and substantiality of the portion used in relation to the copyrighted work as a whole. Koons appropriated the entire photograph.

The fourth factor, the effective of the use upon the potential market for or value of the copyrighted work, is regarded as "the most important, and indeed, central fair use factor." *Stewart* at 1769, quoting the *Nimmer* text. Koons argues that this factor militates in favor of fair use because his sculpture does not compete directly in the market place with Rogers' photograph. But it need not do so. In *Stewart* the owners of the infringing motion picture argued that the film would not prejudice the story's sale in book form, and that the re-release of the film may even "have promoted sales of the underlying story in the book medium." 863 F.2d at 1482. That argument failed because, in the Ninth Circuit's view, the film distributors' commercial use of a copyrighted story "adversely affects the story owner's adaptation rights." *Ibid.* The Supreme Court accepted that conclusion as well, stating at 1769:

> The record supports the Court of Appeals' conclusion that re-release of the film impinged on the ability to market new versions of the story. Common sense would yield the same conclusion.

The focus, in other words, is upon potential markets. In the case at bar, Rogers has shown through the affidavits of competent experts that photographers may earn additional income through the sale of "art rendering" rights, namely, creating an art work based on the photograph in a medium other than photography. *See* affidavits of Arnold Newman and Jane S. Kinne. Counsel for Koons said at oral argument that Rogers had expressed no prior interest in the art rendering submarket prior to this litigation. Rogers states in his affidavit that he is contemplating additional uses for his photograph. I do not think the case turns upon Rogers' past conduct

or present intention as much as it does upon the existence of a recognized market for new versions or new uses of the photograph, which unauthorized use clearly undermines.

I conclude that this factor, together with the others, militates against fair use.

In *Stewart* the Supreme Court said:

> The motion picture neither falls into any of the categories enumerated in § 107 nor meets the four criteria set forth in § 107. "[E]very [unauthorized] commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright." *Sony Corp. of America v. Universal Studios, Inc.*, *supra*, 464 U.S., at 451, 104 S.ct., at 793.

In those circumstances the Court held that defendants' use of the motion picture was not fair use. I reach the same conclusion with respect to Koons' use in his sculpture of the Rogers photograph.

Accordingly plaintiff is entitled to injunctive relief against both defendants.

Claim for Money Damages

Rogers seeks summary judgment against both defendants for money damages in the amount of $367,000. He contends that amount constitutes the "infringing profits" as specified by 17 U.S.C. § 504(b), which provides:

> The copyright owner is entitled to recover the actual damages suffered by him or her as a result of the infringement, and any profits of the infringer that are attributable to the infringement and are not taken into account in computing the actual damages. In establishing the infringer's profits, the copyright owner is required to present proof only of the infringer's gross revenue, and the infringer is required to prove his or her deductible expenses and the ele-

ments of profit attributable to factors other than the copyrighted work.

As to "deductible expenses," Rogers contends that Koons has not sufficiently quantified them in his summary judgment papers.

I agree that Koons did not attempt in his motion papers a detailed accounting of deductible expenses. But he did refer in his brief to deposition and documentary evidence addressing the issue. Rogers' reply brief quarrels with the deductibility of some of the expenses referred to in the documents produced in discovery. That demonstrates the existence of triable factual issues on the point. I decline to construe Rule 56 so as to preclude Koons from an opportunity to prove at trial the amount of deductible expenses, where it is clear that they must have been incurred in some amount and Koons has indicated in discovery the sort of proof upon which he will rely.

Rogers also seeks damages against Sonnabend Gallery, Inc., Koons' principal gallery which displayed the infringing sculptures. Plaintiff's claim against Sonnabend is not addressed in the briefs. His theory of recovery against Sonnabend is not entirely clear. There is no contention that Sonnabend had anything to do with the creation of the sculpture. Presumably Rogers proceeds against Sonnabend on the theory that "one who, with knowledge of the infringing activity, induces, causes or materially contributes to the infringing conduct of another, may be held liable as a 'contributory' infringer." *Gershwin Publishing Corp. v. Columbia Artists Management, Inc.*, 443 F.2d, 1159, 1162 (2d Cir. 1971) (footnote omitted). I accept that Sonnabend's conduct in advertising and displaying the infringing sculptures materially contributed to Koons' infringing conduct. But Sonnabend must have had knowledge of the infringing activity to be liable on this theory. Plaintiff does not call my attention to any evidence in the record that responsi-

ble persons at Sonnabend knew Koons had copied the Rogers photograph.

On this record, therefore, plaintiff's motion for summary judgment for money damages is denied as to both defendants.

Defendants' cross-motion for summary judgment dismissing the complaint is denied for reasons that appear sufficiently from the foregoing discussion.

Plaintiff's motion summary judgment is granted in part and denied in part. Defendants' cross-motion for summary judgment is denied. Plaintiff's counsel is directed to settle an Order and Judgment on seven (7) days' notice within thirty (30) days of the date of this Opinion. The case will thereafter be called for further status conference.

It is SO ORDERED.

Dated: New York, New York
December 10, 1990

/s/ Charles S. Haight, Jr.
CHARLES S. HAIGHT, JR.
United States District Judge

APPENDIX C

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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89 Civ. 6707 (CSH)

ART ROGERS,

Plaintiff,

-against-

JEFF KOONS and SONNABEND GALLERY, INC.,

Defendants.

MEMORANDUM OPINION AND ORDER

HAIGHT, *District Judge*:

Following entry of this Court's Memorandum Opinion and Order dated December 10, 1990, familiarity with which is assumed, plaintiff made a timely motion for reargument pursuant to Civil Rule 3(j) of this Court.[1] Upon consideration, the motion for reargument is granted, and judgment for infringement will enter against defendant Sonnabend Gallery, Inc.

I am not at all certain that Sonnabend is vicariously liable for Koon's infringement under *Shapiro, Bernstein & Co. v. H.L. Green Co.*, 316 F.2d 304 (2d Cir. 1963), the case plaintiff relies upon for that theory of liability. Vicarious liability, the Second Circuit said in *Shapiro*, "depends upon a detailed examination of the relationship

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[1] There is no basis for defendants' characterization of the motion as one under Rule 59, Fed.R.Civ.P.

between" the primary infringer (in this case Koons) and the one sought to be held vicariously liable (in this case Sonnabend). 316 F.2d at 306. In *Shapiro* the defendant held vicariously liable operated a chain of retail stores. The primary infringer operated the phonograph record departments at concessionaire in those stores, and sold records which infringed the copyrights of plaintiffs, proprietors of musical compositions. The store owner, defendant H.L. Green Co., Inc. exacted from its concessionaire a licensing agreement which provided that the concessionaire's employees were to "abide by, observe and obey all rules and regulations promulgated from time to time by H.L. Green Company, Inc. . . ." Green also had the authority, in its "unreviewable discretion," to discharge any concessionaire employee believed to be conducting himself improperly. *Ibid.* In those particular circumstances, the Second Circuit regarded Green as bearing a closer resemblance to "the proprietor or manager of a dance hall leasing his premises to or hiring" an infringing dance band (vicariously liable), as opposed to a "landlord leasing his property at a fixed rental to a tenant who engages in copyright-infringing conduct on the leased premises" (not vicariously liable). *Id.* at 307.

In the case at bar, Sonnabend did not exercise that degree of supervision and control over Koons that Green did over its infringing concessionaire. As far as the dance hall cases go, the arguments fairly cut both ways. Neither party at bar cites an art gallery case, nor have I found one, which leads me to comment with Judge Kaufman in *Shapiro* upon the surprising dearth of squarely applicable precedents in "a business setting so common that the dearth of precedents seems inexplicable," *id.* at 305.

However, Sonnabend was unquestionably a seller of Koons' infringing sculptures. I agree with Rogers that Sonnabend is accordingly a direct infringer under *F.W. Woolworth Co. v. Contemporary Arts, Inc.*, 344 U.S. 228

(1952). Woolworth sold cocker spaniel statuettes which, without Woolworth's knowledge, infringed the plaintiff's copyright. Woolworth was held liable as a direct infringer.

Counsel for Sonnabend argues that *Woolworth* did not address the point at issue. It is the fact that the Supreme Court granted certiorari "limiting the issues to the measure of recovery, as to which conflict appears among the lower courts." 344 U.S. at 229 (footnotes omitted). However, in its recitation of the facts, the court stated unequivocally:

> Unbeknown to Woolworth, these dogs had been copied from respondent's and by marketing them it became an infringer. *Ibid.*

I must regard that statement either as something the Court tossed off without thinking about it, or as a statement of what the Court conceived to be applicable copyright law. I adopt the latter interpretation. *See also* Justice Black's dissent at 234: "The earthenware dogs found to infringe respondent's copyright were bought by F.W. Woolworth Company in good faith at a total cost of $914.40."

Judge Goettel of this Court expressed the same principle more recently in *Kieselstein-Cord v. Accessories By Pearl, Inc.*, 489 F.Supp. 732, 737 (S.D.N.Y.) *reversed on other grounds*, 632 F.2d 989 (2d Cir. 1980):

> The fact that defendant did not copy the Winchester Buckle but instead allegedly bought unauthorized copies from a manufacturer without notice to defendant of the copyright does not affect the validity of the copyright or defendant's liability for infringement. If defendant has should the unauthorized copies, which he admits, defendant's liability—given a valid copyright—is established. The infringer's

claimed lack of knowledge of the copyright affects only damages, not basic liability and injunctive relief.

(footnote omitted).

In the case at bar, Sonnabend was identified as the seller on the sales invoices for the sculptures, and realized 50% of the infringing profits. I think that Sonnabend is a directly infringing seller within the principle of law articulated in *Woolworth*. This Court's prior Memorandum Opinion and Order is amended accordingly.

It is SO ORDERED.

Dated: New York, New York
February 22, 1991

/s/ Charles S. Haight, Jr.
CHARLES S. HAIGHT, JR.
United States District Judge

APPENDIX D

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

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89 Civ. 6707 (CSH)

ART ROGERS,

Plaintiff,

-against-

JEFF KOONS and SONNABEND GALLERY, INC.,

Defendant.

ORDER AND JUDGMENT

HAIGHT, *District Judge*:

This action came on for hearing before the Court, Honorable Charles S. Haight, Jr., District Judge, presiding, upon plaintiff's motion for summary judgment on his copyright infringement claim and defendants' motion for summary judgment dismissing the complaint, and the issues having been duly heard and a Memorandum Opinion and Order, dated December 10, 1990, having been duly rendered, and that Memorandum Opinion having been amended by a Memorandum Opinion and Order dated February 22, 1991, the Court's Order and Judgment dated January 3, 1991, is hereby withdrawn and vacated; and

It is ORDERED, ADJUDGED and DECREED that defendant Jeff Koons, his employees, agents, affiliates and all those acting in concert therewith, and defendant Sonnabend Gallery, Inc., its officers, directors, employees, shareholders, agents and all those acting in concert therewith are ENJOINED and RESTRAINED from infringing plaintiff's copyright in his photograph entitled "Pup-

pies" by making, causing to be made, selling, leasing or distributing in any manner, lending, arranging for the loan of, displaying, or arranging for the display of, any works constituting copies of, or derivative works based upon, "Puppies", including but not limited to the sculpture "String of Puppies" or any photograph or representation thereof; and it is further

ORDERED, ADJUDGED and DECREED that the defendant Jeff Koons and Sonnabend Gallery, Inc. shall within twenty days, deliver to plaintiff's counsel all articles in their possession, custody or control that infringe plaintiff's copyright in his photograph entitled "Puppies", including, but not limited to, any editions of the sculpture "String of Puppies" and any photographs or representations thereof.

Dated: New York, New York
March 27, 1991

/s/ Charles S. Haight, Jr.
CHARLES S. HAIGHT, JR.
United States District Judge

APPENDIX F

UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

At a stated term of the United States Court of Appeals for the Second Circuit, held at the United States Courthouse in the City of New York, on the 18th day of May one thousand nine hundred and ninety two.

Docket Number: 91-7396 (L)

ART ROGERS,
Plaintiff-Appellee-Cross-Appellant,

v.

JEFF KOONS; SONNABEND GALLERY, INC.,
Defendants-Appellants-Cross-Appellees.

A petition for rehearing containing a suggestion that the action be reheard in banc having been filed herein by

Upon consideration by the panel that decided the appeal, it is

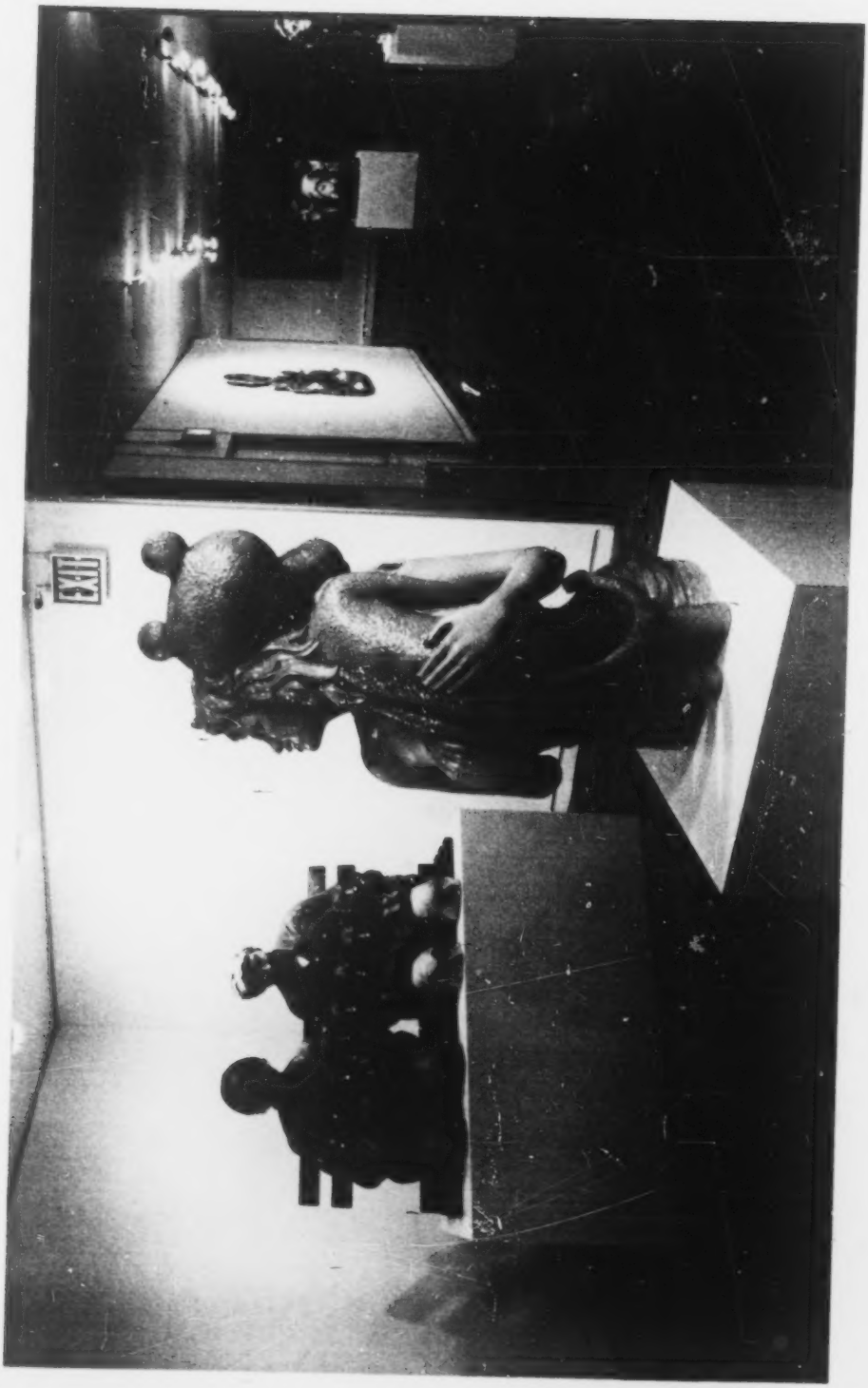
Ordered that said petition for rehearing is DENIED.

It is further noted that the suggestion for rehearing in banc has been transmitted to the judges of the court in regular active service and to any other judge that heard the appeal and that no such judge has requested that a vote be taken thereon.

/s/ Elaine B. Goldsmith
ELAINE B. GOLDSMITH
Clerk

APPENDIX G

APPENDIX H


EXIT

Supreme Court, U.S.
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No. 92-297

IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM 1992

JEFF KOONS,

Petitioner,

—against—

ART ROGERS and SONNABEND GALLERY, INC.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Second Circuit

BRIEF FOR RESPONDENT ART ROGERS — IN OPPOSITION

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September 11, 1992

QUESTION PRESENTED

Pursuant to this Court's Rule 15.1, we note that in Respondent Rogers' view, the questions stated in the Petition for Certiorari are not, in fact, properly presented for review in this case. Both questions are based on erroneous premises. The first question's premise is that the lower court rejected petitioner's defense of "fair use" solely because petitioner received compensation for the infringing work. The second question's premise is that the lower court rejected petitioner's argument under the parody branch of "fair use" solely because the infringed work is not sufficiently well known to be recognized as an object of the alleged parody. The lower court employed no such reasoning. As § 107 of the Copyright Act requires, it considered all of the relevant factors and concluded that petitioner did not make "fair use" of respondent's work as a matter of law on the facts presented. Neither of the considerations petitioner attempts to isolate was determinative. Accordingly, the only question concerning the "fair use" defense that can fairly be said to be presented for review is:

1. Did the court of appeals and the district court err in holding that, on the undisputed material facts in this case, no reasonable fact finder could conclude that petitioner made "fair use" of respondent's photograph in producing and marketing petitioner's sculpture?

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM 1992

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No. 92-297

JEFF KOONS,

Petitioner,

—against—

ART ROGERS and SONNABEND GALLERY, INC.,

Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Second Circuit

BRIEF FOR RESPONDENT ART ROGERS IN OPPOSITION

Respondent Art Rogers respectfully requests that this Court deny the petition for writ of certiorari seeking review of the Second Circuit's decision in this case. That decision is reported at 960 F.2d 301 and is reprinted in the Appendix to the Petition ("Pet. App.") at 1a.

This is an action for copyright infringement and unfair competition by professional artist and photographer Art Rogers, who created and owns the copyright in the photograph "Puppies". It was brought against well-known contemporary artist Jeff Koons, who obtained a copy of that photograph, tore off the copyright notice, sent it to a firm of artisans whom he

instructed to produce sculptures that, in Koons' words, "must be just like photo", (Pet. App. at 5a), and then sold the sculptures, which he titled "String of Puppies",[1] for several hundred thousand dollars.

The district court granted Rogers' motion for summary judgment of infringement, rejecting Koons' fair use defense as a matter of law, and concluding that "Koons' sculpture does not criticize or comment upon Rogers' photograph. It simply appropriates it." (Pet. App. at 34a.) The Second Circuit affirmed, concluding far more emphatically that Koons'

> copying was so deliberate as to suggest that [he] resolved so long as [he was a] significant player[] in the art business, and the copies [he] produced bettered the price of the copied work by a thousand to one, [his] piracy of a less well-known artist's work would escape being sullied by an accusation of plagiarism.

(Pet. App. 2a.) Further, the Second Circuit considered and rejected Koons' argument based on the "parody" branch of "fair use", even though it was not raised below.

In considering the "fair use" defense, neither court isolated any one factor and focused on it to the exclusion of others; Rather, both courts balanced all the factors involved and concluded that no reasonable fact finder could conclude that Koons had made fair use of Rogers' photograph. Neither court suggested — as Koons suggests to this Court — that a change in any one factor would change the outcome.

The Writ of Certiorari should be denied here because (a) both the district court and the court of appeals correctly decided the

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[1] Because of the poor quality of the reproduction of the infringed work in the Appendix to the Petition (Pet. App. at 48a), the infringed work "Puppies" and the infringing work "String of Puppies" are reproduced as an Appendix to this brief, at A1-A2.

case, (b) the decision below is not in conflict with a decision in any other circuit or any controlling decision of this Court, and (c) there are no issues of sufficient importance to merit this Court's review.

STATEMENT OF THE CASE

A. Art Rogers and "Puppies"

Art Rogers has been a professional artist and photographer for over 25 years.[2] (JA[3] 32.) He makes his living by creating, exhibiting and publishing his photographic works, and making secondary use of various rights in them. (JA 32.)

Rogers made the photograph "Puppies" in 1980. (JA 34.) Jim Scanlon, the man who appears in the photograph and the sculpture, commissioned it. He knew Rogers' work and wanted what he terms "his genius, his special 'magic,' " in a portrait of a new litter of German Shepherd puppies. (JA 35, 67-69.)

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[2] Rogers has lived and worked in Point Reyes, California, a rural coastal town about 50 miles from San Francisco, since 1971. Over the course of his career, Rogers' works have been regularly exhibited at galleries and museums in California and as far away as Buffalo and Miami. In 1982, ten of his works, including "Puppies," were exhibited at the San Francisco Museum of Modern Art. His work is in the permanent collections of several museums, including the San Francisco Museum of Modern Art. Rogers and his work have, in addition, been featured in general interest and photography magazine articles, including a recent presentation of his work in a special edition of Life Magazine on the Family, and on television programs. His photographs regularly appear in his photographic column in the Pulitzer Prize-winning newspaper the *Point Reyes Light*, called "The Point Reyes Family Album." In 1986, Rogers received a Guggenheim Fellowship to further his work. (JA 32-34.) Rogers received a fellowship from the National Endowment for the Arts in 1991.

[3] Citations to "JA ____" are to the Joint Appendix filed in the Second Circuit.

After arriving at the Scanlon's home for the photo session, Rogers decided that the puppies alone would not make a successful photograph and chose to include Scanlon and his wife, Mary, holding them. (JA 35, 64-66.) At the photo session, and later in his lab, Rogers created "Puppies," drawing on his fifteen years of artistic development.[4]

After the Scanlons purchased the prints of "Puppies" they wanted, the photograph became part of Rogers' catalogue of images available for further use, from which Rogers, like most professional photographers, makes his living. (JA 32, 38, 835, 855.) The photograph has been used a number of times. "Puppies" was published in Rogers' photography column in the *Point Reyes Light* in 1980 and was exhibited, along with other works by Rogers, at the San Francisco Museum of Modern Art in 1982. A signed print of "Puppies" has also been sold to a private collector. In 1989, the photograph was licensed for use in an anthology called "Dog Days." (JA 38-39.) In addition, Rogers planned to use "Puppies" in a series of hand tinted prints of his works, and it remains available for other uses in the future, including reproduction in various forms or as the basis for various types of derivative works. It is a high quality negative that can be reproduced in virtually any size, including very large murals or

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[4] Substantial creative effort went into both the composition and production of "Puppies." For example, at the Scanlon's home Rogers selected the natural light used, the location, the bench on which the Scanlons sit and the arrangement of people and puppies. He also made creative judgments concerning f/stop and shutter speed that allowed the use of natural light, rather than introducing artificial light, which would have changed the character of the photograph. This resulted in a set of "contact sheets," containing some 50 different images, from which Rogers selected the one that was clearly "it." This decision involved, among other factors, selecting the pose and arrangement of puppies and people that would make the most successful work. In the lab, Rogers again drew on his artistic skill and judgment in printing "Puppies." This required a series of adjustments of contrast — the balance between light and dark — to get the image the way he wanted it. (JA 35-37, 54-63, JA 68-69.)

projections. (JA 37-38, 40.) A good photograph such as "Puppies" can have a long, productive useful life for its copyright owner, including a variety of both planned and unforeseen uses. (JA 39.)

Most significantly for this case, in 1984, Rogers licensed "Puppies", along with other works, to Museum Graphics, a company that produces and sells note cards and postcards with high quality reproductions of photographs by such well-respected American photographers as Ansel Adams, Edward Weston, Brett Weston and Imogen Cunningham. Museum Graphics has produced and distributed the "Puppies" notecard since 1984. (JA 34, 38-39, 44-52, 66.) In 1987 or 1988, Jeff Koons purchased at least two of these notecards. (JA 221-24, 436, 437.)

B. Jeff Koons and "String of Puppies"

Jeff Koons is a well-known professional artist and sculptor residing in New York whose work is sold to the public at substantial prices and exhibited at galleries and museums in the United States and elsewhere. (JA 6, 16.) As the court of appeals noted

> He is a controversial artist hailed by some as a "modern Michelangelo" while others find his art "truly offensive." A New York Times critic complained that "Koons is pushing the relationship between art and money so far that everyone involved comes out looking slightly absurd."

(Pet. App. 4a.)

During 1987 and 1988, Koons, financed by the Sonnabend Gallery,[5] produced a group of 20 works for what he termed his "Banality Show." (JA 179-80, 431.) All the works were sculp-

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[5] The Sonnabend Gallery in New York's Soho district paid the "production costs" of Koons' work and handled its sale and display. (JA 7, 16, 162-68.)

tures in various media, including several in "Polychromed Wood," *i.e.*, wood painted different colors. (JA 191-92, 431.) Each work was produced in an "edition" of three, meaning that three copies were initially made available for sale to the public. (JA 184-85.) A fourth copy of each sculpture was also produced for Koons personally. (JA 186, 287-88.)

Prices for the Banality Show works ranged from $50,000 to $250,000 each. The combined price tag for the 60 editions was $6.63 million. (JA 190-91.)

Koons himself did not, as he put it, "labor over the aspects of physical production of" the Banality Show works. (JA 192-93.) Others made them for him. His role was to "conceive of them" and to "oversee every aspect of production." (JA 192-93.) Italian artisans actually made the "polychromed" wood pieces in the Banality Show, including "String of Puppies," the infringing work in this case. (JA 198-99, 219, 434.)

To make "String of Puppies," Koons gave his artisans, at the Demetz Studio in Ortessi, Italy, one of the "Puppies" notecards he had purchased (after first tearing off Rogers' copyright notice), and told them to copy it. (JA 221-24, 437.) As the court of appeals explained

> [I]n order to guide the creation of a three-dimensional sculptural piece from the two-dimensional photograph, Koons communicated extensively with the Demetz Studio. He visited it once a week during the period the piece was being carved by the workers and gave them written instructions. In his "production notes" Koons stressed that he wanted "Puppies" copied faithfully in the sculpture. For example, he told his artisans the "*work must be just like photo*—features of photo must be captured;" later, "*puppies need detail in fur.* Details—Just Like *Photo!*;" other notes instruct the artisans to "*keep man in angle of photo*—mild lean to side & mildly forward—same

> for woman," to "keep woman's big smile," and to "keep [the sculpture] very, very realistic;" others state, *"Girl's nose is too small. Please make larger as per photo;"* another reminds the artisans that "The puppies must have variation in fur *as per photo*—not just large area of paint—variation *as per photo."*

(Pet. App. 5a-6a; emphasis and brackets Second Circuit's.)

After completion, "String of Puppies" was displayed at the Sonnabend Gallery in December 1988, and three of the copies were sold to collectors for a total of $367,000. (JA 431.)

Koons' use of "Puppies" to create "String of Puppies" was completely unauthorized. He never sought permission from Art Rogers to use the photograph.[6] (JA 40,-302-03.)

Rogers learned of Koons' unauthorized use through Jim Scanlon, one of the subjects of "Puppies." A friend of Scanlon's who was familiar with the photograph, called to tell him that what she took to be a "colorized" version of "Puppies" was on the front page of the calendar section of the May 7, 1989 Sunday *Los Angeles Times*. In fact, as she and Scanlon later learned, the newspaper actually showed Koons' "String of Puppies" in connection with an article about its exhibition at the San Francisco Museum of Modern Art. (Pet. App. 6a; JA 69-70, 869-70, 871.)

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[6] Koons' failure to seek permission was deliberate, not inadvertent. Koons' documents show that he was well aware that he had to obtain permission to use copyrighted material in his works. In numerous prior instances, he had asked for, and obtained, permission to use others' copyrighted material. (JA 96-132.) Further, the Italian artisans expressly called to Koons' attention the possibility that the works they made for him might infringe copyrights and that Koons was responsible for obtaining permission. They noted in a March 30, 1988 letter to Koons, "We must bring to your attention that the permission for copyright is not our business." (JA 502.)

C. *Prior Proceedings*

After Rogers filed this action, "Both sides advised the district court at an early stage of the proceedings that, at least as to copyright infringement, disputed factual issues were unlikely and disposition on summary judgment would probably be appropriate." (Pet. App. 7a.) After discovery, the parties cross-moved for summary judgment, with Rogers' motion limited to his copyright infringement claim. The district court granted Rogers' motion as to liability and turnover relief pursuant to 17 U.S.C. § 503, but found that disputed questions of fact concerning computation of infringing profits precluded an award of damages at that time. (Pet. App. 25a-44a.) On March 27, 1991, the district court entered an injunction barring further infringement and requiring turnover of the remaining infringing work.[7] (Pet. App. 45a-46a.)

Defendants appealed to the Second Circuit. On appeal, Koons raised for the first time the argument that his sculpture was a "parody" or "satire" of Rogers' photograph, and therefore a "fair use" of that work.[8] The Second Circuit nevertheless considered

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[7] When Koons failed to comply with the turnover provision of the injunction, Rogers moved for contempt. The contempt proceedings revealed that nine days after the injunction was issued, Koons had shipped the remaining sculpture to Germany on loan to a Berlin museum. (JA 976-77.) After a hearing, the district court held Koons in contempt and ordered him to repatriate the sculpture and turn it over to Rogers. (JA 1017-18.) The Second Circuit denied Koons' motion to stay the injunction, and the sculpture has been turned over to Rogers.

[8] In the district court, Koons made no more than a "faint suggestion" at oral argument that "the sculpture, together with the other works in the 'Banality Show', were intended to comment satirically upon contemporary values." (Pet. App. 34a.) In fact, the claim that the sculpture was intended to comment on or criticize the photograph finds no support in the record. It was an after-the-fact construction by Koons' lawyers in an attempt to excuse his infringe-

(continued...)

that argument and affirmed the grant of summary judgment.[9] In considering Koons' "fair use" defense, the court of appeals fully analyzed each of the fair use factors identified in § 107 of the Copyright Act, and also noted that because "fair use" is an equitable doctrine, Koons' bad faith in willfully using Rogers' work without permission militates against a finding of fair use. (Pet. App. 13a-21a.) That court concluded that summary judgment should be affirmed because no reasonable fact finder could weigh the undisputed facts involved and conclude that Koons had made "fair use" of Rogers' photograph.

REASONS FOR DENYING THE WRIT

1. ***The Case Was Correctly Decided Below on the Undisputed Facts*** — The district court and the court of appeals fully considered Koons' "fair use" defense and carefully weighed all the relevant factors. Both concluded that the defense must be rejected as a matter of law because no reasonable fact finder could balance the undisputed facts and find for Koons on "fair

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[8](...continued)
ment. The "message or artistic statement" of the Banality Show works that Koons articulated in the record was, "to remove the guilt and shame of the bourgeois, so that they have self-confidence to create a new aristocracy, a new upper class." Sending this message involved "us[ing] masturbation guilt to help focus the audience on what the theme is about," *i.e.*, "removing guilt and shame." (JA 385-86.) Moreover, Koons submitted affidavits from modern art experts expressly disclaiming that "String of Puppies" was attempting to comment on or criticize the Rogers photograph. (JA 897, 915-16.) Having thus contended that the two works are wholly unrelated, Koons is hard pressed to urge this Court that his sculpture draws its significance from, or delivers its message by, comment on or criticism of the photograph, or "sought to criticize the very essence of" the photograph (Pet. 21).

[9] The issue of calculation of damages and infringing profits on Rogers' copyright infringement claim, along with the unfair competition claims for relief in Rogers' complaint, are awaiting trial in the district court.

use". Those determinations were accurate and there is no reason for this Court to disturb them or review them.

Although dressed up to assert that this case raises "issues of critical importance" meriting review, at bottom, Koons' Petition for Certiorari merely urges that the Second Circuit's decision was erroneous — claiming that it "makes no sense" (Pet. 16) or complaining about "[t]he flimsiness of the court's reasoning" (Pet 17). Although we submit that it is Koons' claims of error that are "flimsy", even if his claims were well-taken, mere error below is insufficient to invoke this Court's certiorari jurisdiction. *Ross v. Moffitt*, 417 U.S. 600, 617 (1974).

Moreover, where the decision turns on a balancing of the particular facts of the case, as was involved in rejecting Koons' "fair use" defense, grant of certiorari is an inappropriate use of the Court's limited resources. *See Texas v. Mead*, 465 U.S. 1041 (1984); *United States v. Johnston*, 268 U.S. 220, 227 (1925). This is particularly true where, as here, both the district court and court of appeals have reached the same result. *See, e.g., NCAA v. Board of Regents*, 468 U.S. 85, 97n.15 (1984); *United States v. Doe*, 465 U.S. 605, 614 (1984); *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 336 U.S. 271, 275 (1949).

2. ***The Second Circuit's Decision is not in Conflict with Any Other Circuit or with Decisions of this Court*** — Koons cannot, and does not, claim that the Second Circuit's decision creates a conflict among the circuits on any issue or is inconsistent with any of this Court's decisions. That being so, we submit that the case does not raise any copyright law issue of sufficient importance to merit this Court's attention in the absence of a direct conflict.

In particular, the record completely refutes what Koons terms his "most compelling argument for review here", that the "entire post-modern movement [in art] has now been placed in jeopardy by" the Second Circuit's decision that Koons' unauthorized use of Rogers' photograph infringed Rogers' copyright. (Pet. 22.) Contrary to that assertion, the record reflects that the need to

obtain permission or a license to base a post-modern artwork on another artists' copyrighted material has not significantly inhibited post-modern artists. For example, Koons holds up the work of Andy Warhol as "[o]ne well known example" of post-modernism. (Pet. 3.) As the record shows, when Andy Warhol wished to base his works on copyrighted photographs, he purchased from the photographers "the right to transform each and every" such photograph into artworks "in his style". (JA 856, 931-32.) Warhol had a long, prolific and successful career without asserting the right Koons urges to use others' copyrighted works without permission or compensation.

The record also shows that the need to obtain permission to use copyrighted works in his art has not significantly inhibited Jeff Koons himself. Prior to his Banality Show, Koons routinely, and successfully, sought written permission from copyright owners to use their copyrighted material in his artworks. (JA 96-132; see note 6 above.) Despite that practice, he was able to express himself artistically and achieved wealth, fame and critical success.

Moreover, there are an infinite number of uncopyrighted mass produced and widely distributed items that Koons and other post-modern artists can "appropriate", and have appropriated, to make their artistic statements. Koons, in fact, has "appropriated" a number of these uncopyrighted, mass-produced items — *e.g.*, basketballs, vacuum cleaners, inflatable rabbits — into prior works. Indeed, the acknowledged progenitor of post-modernism, Marcel Duchamp (Pet. 3), initiated the movement with his incorporation of an uncopyrighted urinal into a work of art.

There is thus no support whatever for the proposition Koons urges that the need to obtain permission or a license to "appropriate" copyrighted images significantly impacts the post-modern art movement.

3. ***The Issues Koons Desires to Raise Are Neither Worthy of Certiorari nor Properly Presented in this Case*** — Koons asks this Court to grant certiorari, in the absence of any conflict among the circuits, to decide (a) whether a "work of art" copied from

another artist is "actionable commercial exploitation simply because its creator was paid for that work", and (b) whether copying from another artist's work can qualify as protected "parody" or "satire" where the copied work is insufficiently well known to be recognized as the object of the parody or satire. (Pet. i.) The writ should be denied because the Second Circuit's treatment of the profit/non-profit distinction, and of Koons' parody/satire argument, in assessing the "purpose and character" fair use factor does not indicate that lower courts need this Court's guidance in these areas, and, in any event, these "questions" are not squarely presented on this record.

a. The Profit/Non-Profit Distinction

As to the profit/non-profit distinction, the Second Circuit's application of the existing guidance from this Court produced an entirely reasonable result, given the undisputed facts. Without requiring any judgment on the artistic merit of Koons' work, or on Koons as an artist, the facts demonstrate such a decidedly commercial use of Rogers' work that weighing the "purpose and character" fair use factor in Rogers' favor was the only reasonable result.

The type of contemporary art that Jeff Koons produces and the Sonnabend Gallery (which Koons described as a "commercial" gallery (JA 146)) sells is a big business with enormous profits. The disparity between the $367,000 realized for the three "String of Puppies" sculptures and the $27,300 Koons paid his artisans to make them (JA 879) shows this vividly.[10] Realizing these extremely high prices for his works is not merely a byproduct of Koons' artistic endeavors, or a tribute to his professional standing, it is one of his express goals. He has stated that, "I like the idea of my work selling for a lot of money. That's very sexual to me" (JA 500), and that he produces his

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[10] The differential was similar for other "Banality Show" works. For example, the artisans received $9,470, $9,500 and $8,750, respectively for statues that sold for $125,000, $150,000 and $100,000, respectively. (JA 877-78.)

works in editions of three to accommodate "the market" (JA 501). Koons also proclaims, "I'm competitive. I don't think other artists are competitive enough . . . . I don't understand why artists don't want to expand their market share." (JA 514.)

Koons' advertising is also strongly indicative of commerciality. He used Madison Avenue style magazine advertising (JA 881-84, 370-75, 492-99), and billboard advertising (JA 326-27, 375-77), and even formed his own advertising agency (JA 892) to promote his exhibitions. He claims that his magazine ads were "about self-exploitation." (JA 501.)[11]

Further, the Second Circuit did not, as Koons charges, treat the profit/non-profit distinction as a rigid compartmentilization that turned on whether Koons received money for his work. It cited, and followed, this Court's guidance in *Harper & Row Publishers v. Nation Enters.*, 471 U.S. 539, 562 (1985), stating that

> the crux of the profit/non-profit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price.

(Pet. App. 14a.) As the record shows, Koons did not pay the "customary price" here. When an artist wishes to base an artwork in a medium other than photography on another artist's photograph, it is customary to purchase or license the "art rendering rights" in the photograph from the photographer. (JA 536, 836-37, 841-47, 849, 855-56.) Koons attempted to by-pass that purchase here, which would, if sanctioned by this Court, destroy the market for art rendering rights.

Thus, unless this Court is prepared to hold, as Koons appar-

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[11] Koons' claim that his works "criticize . . . the excessively commercial character of the art market" (Pet. 3 n.2) is ironic, in light of the degree of his own commerciality.

ently urges, that even such compelling indicia of commerciality as are presented here are irrelevant to fair use whenever the alleged infringing work purports to be conferring a public benefit by communicating ideas, the Second Circuit's decision shows no need for lower court guidance in this area.

Nor does the Second Circuit's decision concretely present the question Koons urges, "whether a work of art that would otherwise qualify for the copyright defense of 'fair use' becomes a form of actionable commercial exploitation simply because its creator was paid for that work". The Second Circuit made clear that its rejection of the fair use defense did not turn on a determination that Koons received money for the work, but rather was based on evaluation of all the fair use factors. That court stated

> though it is a significant factor, whether the profit element of the fair use calculus affects the ultimate determination of whether there is a fair use depends on the totally of the factors considered; it is not itself controlling,

(Pet. App. 14a) and then proceeded to evaluate the other factors. There is no indication whatever that absent payment to Koons the Second Circuit would have upheld Koons' fair use defense. In fact, that court — and the district court — found that *all* of the other fair use factors militated *against* a finding of fair use.

b. The Parody Branch of Fair Use

Contrary to Koons' claim, the Second Circuit's treatment of his argument that his use of Rogers' work should be protected as parody or satire was entirely appropriate and indicates no need for this Court's guidance. Far from "flatly reject[ing]" Koons' claims of "criticism" or "comment" (Pet. 5), the Second Circuit engaged in a lengthy discussion of those issues (Pet. App. 14a-17a). Koons urges that his sculpture should be protected parody or satire because he is using another artist's work to comment

critically on some aspect of society at large. The Second Circuit rejected that position because Koons' use of Rogers' work does not seek to make its point — even in part — by drawing upon the audiences's familiarity with an original. Without that factor, there is no need for Koons to use the Rogers photograph. Koons is not "conjuring up" the "Puppies" photograph in "String of Puppies" for a satiric purpose. He is merely appropriating it.

As the Second Circuit put it, to qualify as parody or satire, "the copied work must be, at least in part, an object of the parody, otherwise there would be no need to conjure up the original work." (Pet. App. 16a.) As the Second Circuit also recognized, that requirement is the only workable way to delimit parody and satire from mere piracy.

> We think this is a necessary rule, as were it otherwise there would be no real limitation on the copier's use of another's copyrighted work to make a statement on some aspect of society at large. If an infringement of copyrightable expression could be justified as fair use solely on the basis of the infringer's claim to a higher or different artistic use — without insuring public awareness of the original work — there would be no practicable boundary to the fair use defense.

(Pet. App. at 16a.)

This approach is entirely consistent with all of the leading parody cases. For example, *Elsmere Music, Inc. v. National Broadcasting Co.*, 623 F.2d 252, 253 (2d Cir. 1980), considered "I Love Sodom" sung on "Saturday Night Live" to the tune of New York's famous publicity jingle "I Love New York." The court held the "take off" a parody fair use, noting that even more than the minimum necessary to "conjure up" the original could be taken "provided the parody builds upon the original, using the original as a known element of modern culture and contributing something new for humorous effect or commentary." And in *Berlin v. E.C. Publications, Inc.*, 329 F.2d 541, 545 (2d Cir.), *cert.*

denied, 379 U.S. 822 (1964), Mad Magazine's humorous versions of famous songs by Irving Berlin and others were held to be parody fair use. The court allowed the taking required to "recall or conjure up" the originals for humorous effect because it was necessary "if the original was to be recognized."

Fisher v. Dees, 794 F.2d 432 (9th Cir. 1986), is similar. It found that "When Sunny Sniffs Glue" sung to the tune of the well-known "When Sunny Gets Blue" is parody fair use, stating "a parody frequently needs to be more than a fleeting evocation *of an original* in order to make its humorous point" (emphasis supplied)). *Cf. MCA, Inc. v. Wilson*, 677 F.2d 180, 185 (2d Cir. 1981) (a permissible parody need not be directed solely to the copyrighted original but may also reflect on life in general; however, if the original is not at least in part an object of the parody, there is no need to conjure it up, and thus no fair use); *Walt Disney Prods. v. Air Pirates*, 581 F.2d 751, 758 (9th Cir. 1978), *cert. denied*, 439 U.S. 1132 (1979) (defendant's use of Disney characters in adult "counter-culture" comic book not parody fair use because more was taken than necessary to "conjure up" the original; "by copying the images in their entirety, defendants took more than was necessary to *place firmly in the reader's mind* the parodied work" (emphasis supplied)).

This body of case law is not, as Koons suggests, "rather confused". (Pet. 16.) Its soundness indicates that there is no need for the guidance from this Court in applying fair use to parody and satire that Koons urges.

Moreover, as with the profit/non-profit issue discussed above, this case does not concretely present the question Koons delineates. Nothing in the Second Circuit's decision suggests that the outcome turned on the parody/satire question. Even if that court had held that Koons' professed purpose of general social commentary entitled him to some greater fair use leeway, it might well have rejected the defense based on its balancing of other factors. For example, even where legitimate satiric purpose enhances the scope of fair use, greater than necessary copying can defeat the defense. *E.g., Air Pirates*, 581 F.2d at 758. Here,

the lower court found that the amount and substantiality of the copying (the third fair use factor) was so great that "no reasonable jury could conclude that Koons did not exceed a permissible level of copying under the fair use doctrine". (Pet. App. 19a.) A similar result might have been reached here even under Koons' view of the proper scope of parody and satire.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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September 11, 1992

APPENDIX

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Supreme Court, U.S.
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No. 92-297

IN THE
Supreme Court of the United States
OCTOBER TERM, 1992

JEFF KOONS,
Petitioner,
v.
ART ROGERS and
SONNABEND GALLERY, INC.,
Respondents.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Second Circuit

REPLY BRIEF OF PETITIONER

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REPLY BRIEF OF PETITIONER

Respondent Rogers opposes review by arguing that the questions raised here address only two of the determinations made by the Second Circuit in a multi-factor, fact-based decision. This argument is wrong for at least two reasons. First, it is clear that the errors raised by petitioner were central to the court's finding of copyright infringement. Second, in addressing those issues, the court enunciated general rules of law that will affect the scope of the fair-use defense in many different cases. Respondent, in turn has made little effort to show that these rules are either unimportant or legally valid.

1. The suggestion that, in denying petitioner's fair-use claim, the court of appeals merely balanced a large number of relevant factors ignores the fundamental nature of the decision rendered below. The Second Circuit

flatly ruled, on highly questionable grounds, that petitioner's sculpture was a form of "commercial" exploitation and was not a parody or satire. While the court then went on to address additional "fair use" factors, these two basic determinations *controlled* the outcome. Thus, when the court reached what is supposed to be the most important question—whether Koons' work threatened any market injury to Rogers—it *presumed* such injury (in the absence of real evidence and contrary to common sense) based on its prior characterization of the sculpture as a commercial product. *See* Pet. 11.[1] Petitioner merely asks the Court to determine whether this line of reasoning makes sense. This Court has in the past agreed to review the application of the fair-use factors, *see Sony Corp. of America v. Universal City Studios*, 464 U.S. 417 (1984); *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539 (1985), and nothing about the posture of this case, or the scope of petitioner's arguments, counsels against similar review here.

Nor can it really be contended that the Second Circuit's ruling is "fact specific." The court flatly ruled that receipt of substantial prices for works of fine art renders such art "commercial." It also held that an otherwise parodic work cannot be a parody if the prior work is not well known and is not displayed in conjunction with presentation of the parody. These rulings, for the reasons we have stated, reflect little understanding of the

[1] Similarly, respondent notes that the court of appeals objected to the *amount* of the copying undertaken by petitioner, speculating that a "similar result might [thus] have been reached here even under Koons' view of the proper scope of parody and satire." Br. in Opp. at 17. It is hardly clear, however, that if the Second Circuit had understood the sculpture to be an otherwise protected form of artistic commentary, it would still have found infringement on the basis of the amount of copying. *See* Pet. 20 n.21 (citing authorities for the proposition that a valid critique may make substantial use of a prior work).

policies underlying the fair-use doctrine, and will have serious consequences in the broad run of copyright cases that are brought in the Second Circuit and elsewhere.

2. Respondent's efforts to defend the decision of the court of appeals on the merits are plainly unavailing. On the commerciality issue, for example, respondent says literally nothing about why fine artists who seek compensation should be treated differently from authors, critics, journalists, and scholars who often succeed in asserting the fair-use defense when they are paid for what they produce. That issue needs to be resolved.

Respondent does suggest that petitioner should merely have paid for permission to use the Rogers photograph, and that his failure to do so renders his work commercial. Br. in Opp. at 13. But this argument only serves to demonstrate the need for review in this case. In making the argument, respondent joins the Second Circuit in emphasizing this Court's statement in *Harper & Row* that the "crux" of the commercial noncommercial distinction is "whether the user stands to profit from exploitation of the copyrighted material without paying the customary price." *Id.* (quoting 471 U.S. at 562). As noted in the petition, however, this "test" only made sense in a case where the alleged infringer had appropriated a specific right (the right of first publication) that had in fact been sold to others (thereby causing actual commercial injury). Pet. 13 n.14. It will eviscerate fair use if other courts follow the Second Circuit in requiring payment of a "customary price" in every case—*i.e.*, even where there is no such custom and the right at issue would never be sold.

Thus, here, obvious problems will arise if post-modern artists, seeking to ridicule works in mass culture, are forced to seek permission from the creators of prior works. *See* Pet. 23. One of the basic purposes of authorizing non-consensual fair use is to allow subsequent creative efforts that criticize prior works. In such a context,

a licensing scheme is useless.[2] In sum, it remains clear that the lower courts have no idea about how to apply the commercial-use factor in fair-use cases, and that this uncertainty needs to be resolved in light of this Court's statement in *Sony Corp. of America v. Universal City Studios*, 464 U.S. at 451, that commercial use creates a presumption of market injury.

Similarly, respondent offers no real explanation about why petitioner forfeited characterization of his work as a "parody" when he selected a prior work that was not well known to the audience for the sculpture. Petitioner obviously had valid artistic reasons for choosing to base his work on a typical example of mass culture. Moreover, the recognizability of the object of a parody says nothing about the actual impact of the "use" on the commercial interests of the creator of the prior work. This factor therefore bears no relation to the purposes of copyright that should control the outcome in this kind of case. Indeed, the Second Circuit dramatized this fact when it stated that petitioner would have qualified for greater protection if only he had displayed the Rogers photograph with his sculpture. *See* Pet. 17. If he had done so, of course, the potential market impact on Rogers would only have been heightened.

---

[2] Respondent's brief asserts that Koons "routinely, and successfully, sought written permission from copyright owners" in the past. Br. in Opp. at 11. To the contrary, Koons has clearly maintained that he has never sought or needed "permission." The correspondence contained in the record (JA 96-132) represents requests from Koons to liquor and cigarette manufacturers to borrow the original, full-size printers' negative plate for temporary use (JA 362). Simply because the manufacturers responded by granting "permission" does not mean that Koons ever viewed this as necessary. Koons did not consider permission necessary in this case (JA 302-306, 315-319) and did not consider it necessary for any of the twenty Banality works (JA 327-343).

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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MOTION FILED
SEP 14 1992

No. 92-297

IN THE
Supreme Court of the United States
OCTOBER TERM, 1992

JEFF KOONS,
Petitioner,
vs.
ART ROGERS and SONNABEND GALLERY, INC.,
Respondents.

PETITION FOR WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE SECOND CIRCUIT

MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE* AND BRIEF OF NATIONAL ARTISTS EQUITY ASSOCIATION AS *AMICUS CURIAE* IN SUPPORT OF PETITIONER

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No. 92-297

In The
SUPREME COURT OF THE UNITED STATES
October Term, 1992

JEFF KOONS,
Petitioner,
vs.
ART ROGERS and
SONNABEND GALLERY, INC.,
Respondents.

MOTION FOR LEAVE TO FILE BRIEF *AMICUS CURIAE*

National Artists Equity Association respectfully moves for leave to file the accompanying brief as *amicus curiae* in support of Petitioner Jeff Koons. Petitioner and Respondent Sonnabend Gallery, Inc., through their respective counsel of record, have consented to the filing of this brief. Respondent Art Rogers, through his counsel of record, has declined his consent.

National Artists Equity Association (NAEA) is a nonprofit organization with approximately 5,000 members nationwide. Its membership is made up of professional visual artists who work in numerous fields and media, including painting, printmaking, sculpture, and photography. Since its founding in 1947, NAEA has worked to further the aims of visual artists and to address their legal and professional concerns.

This case involves a delicate balance between two important rights, each of which is of critical concern to the members of NAEA. On the one hand, the copyright laws vest in the creators of original works, including works of visual art, certain rights to prevent their copying. Balanced against those property rights are the fundamental rights of artists to comment upon and criticize the world around them. Since the beginning of this century, such creative expression has often included references to symbols and imagery from the popular culture in which they live and work.

The decision of the Court of Appeals for the Second Circuit, while purporting to protect copyrights, failed even to address the significant interest in free expression reflected in the fair use doctrine, and in prior cases that have recognized a defense to infringement actions in cases involving comment and criticism. Its ruling has already had a profound chilling effect on visual artists, who now fear that the common practice of referencing existing images in their work will expose them to liability for copyright infringement

NAEA respectfully submits that the attached brief in support of the petition will provide the Court with additional information regarding the artistic tradition of which Petitioner's work is a part, as well as the chilling effect of a rule, such as that promulgated by the Second Circuit, that would require visual artists to license rights in images that they reference as a condition to their criticizing or commenting on such images. The interests of NAEA and its members would not otherwise be adequately presented by the parties to this case.

For the foregoing reasons, NAEA respectfully requests that the Court grant it leave to file the attached brief *amicus curiae*.

Dated: September 11, 1992.

Respectfully submitted,

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Attorneys for Amicus Curiae
NATIONAL ARTISTS EQUITY
ASSOCIATION

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Cases

Consumers Union Of the United States,
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Iowa State University Research Foundation,
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621 F.2d 57 (2d Cir. 1980). 11

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Walt Disney Productions v. Air Pirates
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Warner Brothers, Inc. v. American
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Statutes

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Miscellaneous

W. Camfield, *Marcel Duchamp: Fountain* (1989). . . 3

C. Greenberg, *American-Type Painting*, in *Modern Art and Modernism: Rethinking Representation* (F. Frascina & C. Harrison eds. 1962). . . . 3

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R. Hughes, *Nothing If Not Critical* (1990). 6

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BRIEF *AMICUS CURIAE*

INTEREST OF *AMICUS CURIAE*

The interest of *amicus curiae* National Artists Equity Association is as set forth in the preceding motion for leave to file this brief in support of the petition for a writ of certiorari.

INTRODUCTION

The central question presented by the petition in this case is whether significant works of artistic expression that reference existing copyrighted works in order to criticize or comment upon those works, or upon society generally, may be deemed infringing, notwithstanding explicit protections for commentary and criticism set forth in the fair use provision of the Copyright Act, 17 U.S.C. § 107.

The Court of Appeals for the Second Circuit found such referential art to be infringing *as a matter of law*, without any inquiry into whether the primary nature of the challenged work was by way of artistic expression, rather than commercial exploitation, and notwithstanding the Court's explicit finding that Koons' sculpture was "a satiric critique of our materialistic society." 960 F.2d at 310. In so holding, the Court of Appeals ignored the clear language of the Copyright Act, and the prior teachings of this Court with respect to the value of artistic expression.

This Court has long recognized that the ultimate purpose of the copyright laws is to serve "the cause of promoting broad, public availability of literature, music and other arts." *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (Stewart, J.). If the law's "ultimate aim is to stimulate artistic creativity for the public good," *id.*, the decision of the Court of Appeals has seriously impeded that aim. Indeed, the Second Circuit's opinion is already having a

profound chilling effect on the creation and exhibition of an important genre of contemporary artistic expression.

STATEMENT

Amicus Curiae National Artists Equity Association is an organization that represents some 5,000 visual artists throughout the United States. Its members care deeply about the copyrights they hold in their original works. At the same time, the artists of this country dearly value their right to speak out through their work on important issues, and to express critical views regarding the world around them.

A. The Artistic Tradition At Issue In This Case

An important function of the arts — and particularly modern and post-modern arts — is to comment on the modern world, including the images and symbols and language that form our popular culture. Since the beginning of this century, referential art — art that references and comments upon existing imagery — has played a seminal role in the ongoing dialogue about what "art" means, and its role in a modern (or post-modern) world.

In addressing the dispute between Jeff Koons and Art Rogers — and the importance of a rule of law that allows legitimate artists to comment critically on existing imagery from the culture around them — it is vitally important to understand the role that referential work has played in twentieth century modern and post-modern art. "Modernism" is a movement that began in the last half of the nineteenth century and thrived in the first half of the twentieth. *See generally Modern Art and Modernism: Rethinking Representation* (F. Frascina & C. Harrison eds. 1962). According to Clement Greenberg, the leading scholar and critic of late modernism, it was a purist movement that derived many of its tenets from romantic notions of creation. *See* C. Greenberg, *Modernist Painting*, in *Modern Art and Modernism, supra*. "Late modernism distinguished between good and bad art by demanding that good art be pure, self-critical, original, sincere and serious." Note, *Post-Modern Art and*

the Death of Obscenity Law, 99 Yale L.J. 1359, 1363 (1990); *see* C. Greenberg, *American-Type Painting*, in *Modern Art and Modernism, supra*.

In the 1920s, Marcel Duchamp mounted a frontal assault on modernism (and, in the process, turned the art world on its head) by importing commonplace objects and images into what were traditionally "artistic" contexts. By displaying banal "found" items from the popular culture in gallery and museum settings, he forced the viewer to confront questions about what separates "art" from the myriad of images and objects that surround us in our everyday lives. Duchamp's exhibition of common, and often vulgar, objects as art enraged many. His *Fountain, see* Appendix A, first exhibited in 1917 (under the pseudonym R. Mutt), was no more or less than a standard urinal from a plumbing supply house, placed on a pedestal. *See* A. Schwartz, *The Complete Works of Marcel Duchamp* at 521 (1969); W. Camfield, *Marcel Duchamp: Fountain* (1989). Commenting upon the work's exclusion from an important exhibition, Duchamp wrote that he "took an ordinary article of life, placed it so that its useful significance disappeared under the new title and point of view — created a new thought for that object." R. Mutt (M. Duchamp), *The Richard Mutt Case* at 5 (1917). Despite the contemporaneous reaction to Duchamp's "readymades" (as they came to be known), it is clear that they became "vehicle[s] for some of the most tendentious and longest-burning intellectual debates in this society." K. Varnedoe & A. Gopnik, *High & Low: Modern Art and Popular Culture* 278 (1990) (hereinafter *High & Low*).

In 1919, Duchamp again enraged the established art world by displaying *as art* a small mechanical reproduction of Da Vinci's Mona Lisa, to which he had added a pencil mustache and goatee. *See* Appendix B. Once again, his attempt was to question then prevailing romantic notions of "art" and creation and, once again, his "borrowing" and defacing a well-recognized icon was unpopular. Over time, it has become

one of the most important examples of an artistic tradition that continues to this day.

The "Pop Art" movement of the 1960s and 1970s was, in a real sense, a continuation of the post-modern dialogue begun by Duchamp. *See* C. Tomkins, *The Bride and the Bachelors: Duchamp, Tinguely, Cage, Rauschenberg, Cunningham* (1968); *High & Low, supra, passim*. By referencing images from "pop" culture, artists such as Roy Lichtenstein, Robert Rauschenberg and Jasper Johns once again demanded of their viewers that they confront difficult questions about the nature of art, and its place in an ever more visually complex society. They began to question, and to challenge, the solemnity inherent in late modern art by incorporating in their work images from the "pop" culture around them. Lichtenstein's cold, flat renditions of imagery (and dialogue) from comic books, *see* Appendices C-1, D-1, referenced a set of representational cliches known to his viewers, whether or not they recognized the specific sources for Lichtenstein's paintings. *See* Appendices C-2, D-2. Rather than parodying or commenting upon particular, well-known panels from the comics, Lichtenstein's work was — and remains — important as a commentary upon a genre. By transforming his source material through choices involving media, size, color and simplification of imagery, his became an important voice in the dialogue about art and mass culture.

Painted Bronze II, *see* Appendix E, is considered one of Jasper Johns' most important contributions to the debate concerning the nature of art, and its relation to imagery found in, and borrowed from, the popular culture. Johns was inspired to create the piece when an artist friend casually remarked that Leo Castelli (a famous art dealer) could sell beer cans, if that was all he had to sell. In response, Johns cast a pair of cans standing on a pedestal, and painted them (somewhat crudely) with the familiar and mundane "Ballantine Ale" logo. As with Duchamp and Lichtenstein,

John's expression was in the editing of popular icons, in their transformation, and in the very act of exhibiting them.

In the minds of many, the acme (or nadir) of referential art was achieved when, in the early 1960s, Andy Warhol exhibited mechanical enlargements of Campbell Soup can labels — images as familiar and banal as any that could be imagined. *See* Appendix F. One critic wrote that, in doing so, Warhol had "liquidated the century-old tension between the serious artist and the majority culture. R. Hughes, *The Rise of Andy Warhol*, in *Art After Modernism: Rethinking Representation* at 54 (B. Wallis ed. 1984). Whatever one may think of Warhol's soup cans, or of Lichtenstein's comic-strips lifted from a widely recognized genre of familiar imagery, there can be no question that such expression played an important part in a valid and valuable creative dialogue.

That dialogue continues to this day. In the 1980s, theories of modernism and post-modernism were debated in the fields of art, architecture, music, literature and even legal scholarship. Among visual artists, the dialogue continued (and continues) to center around questions regarding originality, and is manifest in schools of art that continue to reference "found" images from the popular culture.

In 1990, the Museum of Modern Art in New York mounted an exhibition, entitled "High & Low," that explored the artistic tradition described briefly above. The show, which traveled to Chicago and Los Angeles, was widely hailed as one of the most important of the decade. In an accompanying book of the same name, Kirk Varnedoe, curator of paintings and sculpure at the Museum of Modern Art and the curator of the show, surveyed what he referred to as "one of the most important movements of the twentieth century." *See High & Low, supra*. The show began with the work of Marcel Duchamp. It ended with Jeff Koons.

B. Jeff Koons

As noted by both the trial court and the Court of Appeals, Jeff Koons is an internationally known and highly controversial artist. His work has been exhibited in one-man shows throughout the country, and he is represented in the most prestigious museums and collections in the world. Koons' work has been the subject of innumerable books, catalogs, and articles.

The controversy surrounding Jeff Koons flows primarily from his "thumb-in-the-eye" approach to received models of artistic creation. Koons is perceived by many as a huckster, a salesman, a semi-professional celebrity. He has publicly eschewed romantic notions regarding the artist as divinely inspired creator working outside the realm of commerce, just as his work has eschewed modernist ideals of art as somehow divorced from banality and commonality. His work (and his views) have been characterized as profoundly cynical, and ultimately nihilistic, by some. *See* R. Hughes, *Nothing If Not Critical* at 123 (1990). Others have described his work as among the most daring, challenging and important of the 1980s. *See, e.g., High & Low, supra*, at 392-98. In short, Koons' work (and his personality) have inspired reactions from adoration to revulsion. They are virtually impossible, however, to ignore.

Koons first came to national attention in the early 1980s when, in the tradition of Duchamp (among others), he exhibited existing objects such as industrial vacuum cleaners. The "displaced" object was, by then, a venerable artistic genre; Koons took the next step by displaying objects that were "uncharged" — "they didn't have the thrill of the forbidden or the appeal of the overlooked, just the drudge-like presence of the ignored." *High & Low, supra*, at 393.

In 1986, Koons created what is probably his best-known sculpture, entitled *Rabbit*. *See* Appendix G-1. Starting with a cheap inflatable dime-store toy rabbit, *see* Appendix G-2, Koons exploded it to nearly four feet in size, and had it cast

in highly polished stainless steel. In one sense, *Rabbit* is no more than a slavish copy of a widely recognizable *type* of image from the pop culture. At first glance, it bears none of the "artistic" qualities upon which notions of romanticism or modernism rely; it does not reveal the "hand of the artist." In that, it is more in the tradition of Duchamp's exhibiting a ready made object. Upon closer inspection and reflection, *Rabbit* reflects a whole range of transformational, or "artistic," choices. Its size, and particularly its medium, evoke a response in the viewer that is vastly different from that experienced upon encountering the referenced toy. *Rabbit* is unquestionably funny. At the same time, its coldness and hardness, coupled with its intimidating, hovering presence, renders it ultimately horrifying. There is no question but that in creating *Rabbit*, Koons "copied" — in some sense — the dime-store toy. Yet, by transforming a "cute bunny" in the way he did, he added significantly to the discourse which has been at the heart of modern and post-modern art for more than half a century.

By 1988, Koons had completed a body of work, including the sculpture *String of Puppies*, that he exhibited at the Sonnabend Gallery under the title "Banality Show." The show was a sensation; applauded and reviled in the press and by the public. Kirk Varnedoe, curator of the Museum of Modern Art, has described it as follows:

> "In late 1988, Koons managed to do something that most people thought was no longer possible. He shocked them. . . . Koons' figurines were shocking because of the way they looked. They were nightmarish — devil dolls, in which the insipid language of the cartoons' over-accentuated contours and biscuit glazes was suddenly made hard and staring. The contours of each piece were as chubby as a Disney drawing, but glacially hard — like Muppets which had just seen the Medusa.

. . . .

> . . . The desire to make newly imagined things look vitiated and secondhand seemed to express a preference for death over life, and even in a weary time this remained shocking. . . . It is that same self-protecting morbidity, merged, in this case, with a cheerful entrepreneurial busyness and a strangely ingratiating humor, that radiated from all of Koons' work. For once, the word *postmodernism* seemed meaningful — dead on."

High & Low, supra, at 393-98. As with *Rabbit*, the twenty sculptures in the "Banality Show" were transformed versions of existing images from the popular culture. Some included well-known "pop" characters such as the Pink Panther, Michael Jackson and Odie (the dog from the *Garfield* comic-strip). Others referenced well-known images, transformed in such a way as to alter considerably the viewer's response. Yet others used as their source material images of a genre which was well-known and recognizable, although the *particular* images may not have been familiar. In that sense, the work was in the tradition of Lichtenstein, who relied on knowledge of a type of comic-strip art, rather than the particular comic-strip panel that he referenced.

String of Puppies was among this latter group of sculptures. It relied on and referenced an image of a *type* which was immediately recognizable. It challenged and satirized the sort of "charming," "cute," "romantic," "sentimental" picture with which we are all familiar, and which fills the racks of gift shops. As was true of *Rabbit*, the response evoked by *String of Puppies* is vastly different from that evoked by its source. Rogers' photograph — and other pictures of that ilk — inspire a sort of sentimentality; the viewer is likely to respond with such an emotion, and with little more. The photograph is flat, and playful; it is *real*. It evokes thoughts about real people and puppies, about the moments before and after the picture was taken. One need

not quarrel with the quality or the value of Rogers' photograph to admit that it is of a particular and recognizable *type*, intended to evoke a given response.

String of Puppies evokes an entirely different feeling in its viewers. It is *big*; it is garishly and unnaturally colored; it exists not in a real world, but completely out of context. The limbs of the subjects simply end where the pedestal on which it stands begins. The viewer cannot pretend, as with the photograph, that there is more outside the frame. These people, and their grotesque puppies, are all there are. Then there are the characters themselves, bizarre parodies of smiling people and playful puppies. They appear neither happy nor playful. The faces of the people are frozen in twisted expressions that might appear natural if one could consider the prior or subsequent moment, but that are reduced to the grotesque by Koons' editing. The puppies, once cute and playful, have become a string of mysterious electric blue puppy-like objects with flat white stylized noses. The hardness of the moment is matched by the hardness of the object. The people and their dogs are no longer soft and pliant — they have become as wooden as the material in which they are portrayed. Through his manipulation, Koons has transformed a genre of image in such a way as to comment upon it forcefully, and to require his viewer examine it anew. It is a cheeky and cynical brand of commentary, and one which may be thought to denigrate a type of imagery that many find pleasurable. But, in the end, that denigration is what shocks, and causes a response.

The preceding description of Jeff Koons' work, and of the tradition from which it finds context, is not intended to suggest that his oeuvre is any more deserving of fair use protection than any other. Neither is it intended to suggest that well-known artists are incapable of infringing copyrights, or that their activities are to be judged with any greater level of deference than those of lesser-known artists. If the creation of a work entails an act of legitimate artistic

expression, then, whether or not one approves of the work, the artist's right of expression ought at least to be balanced against the commercial exploitation rights vested in the creator of the underlying work.

One need not adhere to Koons' particular aesthetic in order to deem his work legitimate artistic expression, worthy of some measure of protection under fair use provision of the Copyright Act. One need only admit, unlike the Court of Appeals, that a jury presented with evidence about Koons' work and the tradition from which it derives *might* find that it constitutes an act of serious artistic expression. In light of the last seventy years of modern and post-modern art, it is impossible to conclude as a matter of law that Koons, in creating *String of Puppies*, did no more than copy Rogers' photograph for commercial purposes in an attempt to convert Rogers' expression for his own pecuniary gain.

ARGUMENT

The tension between the two important societal values implicated in this case is manifest: On one hand, artists and authors must be protected with respect to their copyrights in original works, if the creation and dissemination of such works is to be encouraged. On the other hand, this nation's long-standing tradition of artistic freedom requires that artists be free to criticize and comment on the world and the culture around them, including imagery, language and other works which might themselves be protected.

Balancing two such important cultural values is, admittedly, a difficult task. Yet in the past, this Court has sought to strike that balance by respecting both "the interests of authors and inventors in the control and exploitation of their writings and discoveries on the one hand, and society's competing interest in the free flow of ideas, information, and commerce on the other hand." *Sony Corp. of America v. Universal City Studios, Inc.*,, 464 U.S. 417, 429 (1984).

In instances when those competing values have clashed head-on, this Court has given primacy to the societal interest

in creativity and free expression. Protection of a copyright owner's property rights is "a secondary consideration," *id.* (quoting *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 158 (1948)), and subservient to "[t]he primary objective of copyright . . . [which] is to promote the Progress of Science and the useful Arts." *Feist Productions, Inc. v. Rural Telephone Service Co.*, 111 S. Ct. 1282, 1290 (1991). The fair use doctrine, in particular, provides an "equitable rule of reason," *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 448 (1984), the purpose of which is to "avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which the law is designed to foster." *Stewart v. Abend*, 495 U.S. 207, 236 (1990) (quoting *Iowa State University Research Foundation, Inc. v. American Broadcasting Cos.*, 621 F.2d 57, 60 (2d Cir. 1980).

Artists have long taken comfort, and felt some measure of security, in this Court's respect for the value of their creative expressions. Before the Court of Appeals' decision in this case was handed down (and widely publicized), professional artists and art students could fairly believe that their sincerity of purpose, and honest intent to comment on and criticize the world around them, would at least be considered in balancing their rights against the property rights of others. Since that decision was rendered, many artists working in this important genre have perceived that the rules have changed, that referential art is *always* dangerous, and that selling referential art for money is *per se* violative of the Copyright Act.

A. The Second Circuit Erred In Holding As A Matter Of Law That Koons' Work Was A Copy Of Rogers' Photograph.

In holding as a matter of law that Koons' sculpture was a "copy" of Rogers' photograph within the meaning of the Copyright Act, the Court ignored compelling evidence on the question whether Koons' act of transformation was itself a

significant act of artistic expression such that his work could not fairly be characterized as a mere "copy," and adopted an approach which conflicts with that of other circuits, which have held that such decisions are particularly inappropriate for summary judgment. *See, e.g., Twentieth Century-Fox Film Corp. v. MCA, Inc.*, 715 F.2d 1327 (9th Cir. 1983).

With respect to the issue of copying, the Court indulged in an *ad hoc* examination of the superficial similarities of the two works — without making any allowances for their differences, or for the creative expression embodied in Koons' sculpture. There was no question that Koons' made a number of important artistic choices in the process of transforming the photograph into a sculpture, including the addition of unnatural colors, the changing and addition of certain props, the changing and distorting of scale, the choice of material and style of workmanship, etc. Neither was there any dispute that essential elements of Rogers' expression, such as color (or lack of color), light and shadow, contrast and background, were *not* used by Koons. Respected experts submitted affidavits in the trial court concluding that in no sense could Koons' sculpture be deemed substantially similar to Rogers' photograph. Nevertheless, the trial court concluded — without even troubling to view the sculpture — that there was no material fact issue "in light of the overwhelming similarity to the protected expression to the original work," and the Court of Appeals affirmed that finding.

The Court of Appeals erred by failing to consider the transformative process embodied in, and the expressive elements of, Koons' work. At the very least, a jury should have determined whether Koons copied Rogers' work in such a way as to convert to himself the value of Rogers' artistic expression, or whether he merely used the existing image as a jumping off place for his own artistic expression. The Court of Appeals' approach to the question of copying would render actionable much of the work of each of the artists discussed in the previous section. If courts were to have

focused solely on areas of similarity, and ignored critical differences (as well as critically different purposes), we might today be deprived of the products of an artistic tradition which has fostered valuable commentary, criticism and dialogue within our society.

B. Koons' Work Is A Fair Use Of Rogers' Photograph.

Section 107 of the Copyright Act, 17 U.S.C. § 107, provides that the "fair use" of a copyrighted work "for purposes such as criticism [or] comment . . . is not an infringement of copyright." This Court has interpreted the fair use doctrine as a means of allowing artists to "use" prior works in the creation of valuable new works. *See, e.g., Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 549-50 (1985). It bears repeating that the doctrine's very purpose is to avoid application of the copyright laws in such a way as might stifle the creativity which they were intended to foster. *Stewart v. Abend, supra*, 495 U.S. at 236.

In accordance with its open-ended purpose, the language of Section 107 is itself open-ended and inclusive. The statute instructs that fair use "*includ[es]* . . . use . . . for purposes *such as* criticism, comment, news reporting, teaching . . ., scholarship, or research." 107 U.S.C. § 107 (emphasis supplied). It goes on to direct that, in determining whether a particular use is fair, "the factors to be considered shall *include*" four enumerated factors, including (1) the purpose and character of the challenged work, and (2) the effect of the use upon the value of the copyrighted work. Professor Nimmer has noted that the statutory framework has an "almost infinite elasticity," 3 M. Nimmer & D. Nimmer, *Nimmer on Copyright* § 13.05[A][5] at 13-102.6 (1992).

The Second Circuit's categoric approach to Koons' fair use defense ignores the legislative mandate inherent in Section 107, and threatens seriously to chill the types of expression that the statute was intended to protect. As discussed below, the Court decided the first factor by focusing

exclusively on the fact that Koons sold three copies of *String of Puppies* for money. Having concluded from that fact that the purpose of the work was "primarily for profit-making motives," the Court then held *as a matter of law* that *String of Puppies* could not be fairly characterized as commentary or criticism. Finally, the Court concluded that future market harm to Rogers could be presumed based solely on its earlier finding that Koons' motive had been primarily commercial.

The import of the Second Circuit's holding is that the fair use doctrine will not serve to protect works of art that are sold because: (a) their purpose may always be deemed commercial; and (b) such commercial purpose creates a presumption of economic injury to the copyright holder. Such a result ignores the plain language of Section 107.

C. Koons' Work Is In The Nature Of Creative Expression Rather Than Commercial Exploitation.

In an oft-repeated dictum, this Court has stated that the "crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from the exploitation of the copyrighted material without paying the customary price." *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 562 (1985). On the facts of that case, the Court's statement served properly to balance the competing goals of the copyright scheme generally, and the fair use doctrine in particular. Its application to the facts of this case had the opposite effect.

Harper & Row involved the publication by *The Nation* magazine of excerpts from the unpublished memoirs of Gerald Ford, first-time publication rights in which had been licensed to *Time* magazine. This Court correctly noted that *The Nation* could have (but chose not to) bid for first-time rights. Instead, it purloined a copy of proofs of the book and "scooped" *Time* by publishing first. In rejecting *The Nation*'s argument that its primary motive was not

commerce, but news reporting, this Court used the "customary price" language quoted above.

In *Harper & Row*, this Court focused on evidence of practice in the publishing industry to supply the "custom" to which it referred. There is no such custom in the field of fine arts; certainly, none was evidenced in the record before the trial court. Thus, in the field of visual arts, the "customary price" concept becomes circular: Once a court decides that an artist's referential work is commercial (because he or she did not purchase rights), such uses are as a practical matter prohibited unless artists negotiate licenses from copyright holders.

If a "custom" of requiring payment for referenced images in the field of fine arts is created as a result of this case, it will significantly chill artistic expression. For, whereas magazine publishers can make economic decisions about whether to pay for first publication rights in copyrighted books, only a handful of artists are in a position even to consider purchasing rights in the material they criticize and comment upon. A few such artists — including Koons and Johns — may today be in a position to do so. But even those few were not always so situated; they might never have become the artists they are today if, when starting out (or while in art school), they had been required to purchase rights in the imagery they referenced and commented upon.

Moreover, such a rule would restrict the underlying works upon which artists may comment to those whose owners allow them to do so. In situations where an artist seeks to lampoon or criticize an existing work, it will be the rare case in which the holder of the copyright in the work consents — even for a fee. *See Fisher v. Dees*, 794 F.2d at 437 ("Parodists will seldom get permission from those whose works are parodied."). When rights can be purchased, the price may be expected to include some component representing a "criticism fee," notwithstanding the fact that the copyright laws are not intended to compensate copyright

holders for damage caused by critical commentary. *See Consumers Union Of the United States, Inc. v. General Signal Corp.*, 724 F.2d 1044, 1051 (2d Cir. 1983), *cert. denied*, 469 U.S. 823 (1984). In sum, the judicial creation of a "custom" requiring the purchase of a license as a condition to criticizing or commenting upon existing works is antithetical to the very purpose of the fair use doctrine, which is to encourage the free exchange of ideas through commentary and criticism.

D. Koons' Work Is A Parody And Satire Of Rogers' Photograph, And Of Its Genre.

Courts have long recognized that affording satire and parody broad latitude as fair uses is "a means of fostering the creativity protected by the copyright law." *Warner Brothers, v. American Broadcasting Cos.*, 720 F.2d 231, 242 (1983); *see Fisher v. Dees*, 794 F.2d 432 (9th Cir. 1986); *Walt Disney Productions v. Air Pirates*, 581 F.2d 751 (9th Cir. 1978). Just as the drafters of Section 107 explicitly recognized the value of commentary and criticism, judges have treated parody and satire as art forms to be encouraged. *See, e.g., Elsemere Music, Inc. v. National Broadcasting Co.*, 482 F.Supp 741 (S.D.N.Y.), *aff'd*, 623 F.2d 252 (2d Cir. 1980).

The lower courts are in conflict as to whether parody qualifies for fair use protection only where that which is copied is itself the subject of the satire, or whether the defense applies as well to satires of general societal mores. *Compare, e.g., Walt Disney Productions v. Air Pirates*, 581 F.2d 751, 758 n.15 (9th Cir. 1978) (work referenced must be an "object of the parody") and *Metro-Goldwyn-Mayer, Inc. v. Showcase Atlanta Coop. Prods., Inc.*, 479 F.Supp 351 (N.D. Ga. 1979) (in order to qualify as parody, work must "make some critical comment or statement about the original work") *with Elsemere Music Inc. v. National Broadcasting Co.*, 482 F.Supp 741 (S.D.N.Y. 1980), *aff'd*, 623 F.2d 252 (2d Cir. 1980) ("issue . . . is whether the use in question is a valid

satire or parody, and not whether it is a parody of the copied [work]").

In this case, the Court of Appeals held that a challenged work qualifies for fair use protection only if the copied work is, "at least in part, an object of the parody." 960 F.2d at 310. It acknowledged that Koons worked in a tradition dating back to Duchamp that sought to incorporate common images "into works of art in order to comment critically both on the incorporated object and the political and economic system that created it," and explicitly conceded that *String of Puppies* "is a satirical critique of our materialistic society." 960 F.2d at 310. Yet, the Court of Appeals found that the parody/satire defense was inapplicable as a matter of law because it had "difficult[y] discerning any parody of the photograph 'Puppies' itself." *Id.*

In light of the Second Circuit's ruling, the applicability of the parody/satire defense is altogether unclear to innumerable artists whose work references imagery from the culture around them. Moreover, the Court's conclusion that Koons' work was not protected notwithstanding its conceded status as a satirical critique of our society is troubling, and is at odds with the conclusions of other courts. Finally, the Court's finding that it was "difficult to discern any parody of [Rogers'] photograph" is inappropriate on summary judgment, and almost certainly wrong as a matter of fact.

E. Koons' Work Had No Effect On The Economic Value Of Rogers' Right To Exploit His Photograph.

Finally, the Court of Appeals took it upon itself to resolve a factual issue regarding the economic effect, if any, caused by Koons' use of Rogers' photograph. If, indeed, Koons' sculpture were found to have deprived Rogers of his economic rewards of authorship, such a finding might militate against a finding of fair use. But the evidence in that regard was, at best, conflicting and, in fact, provided a basis for finding that no such effect was reasonably likely to occur.

The evidence before the trial court took the form of conflicting affidavits concerning whether there was any established market for rights to make sculptural renditions of existing photographs such as Rogers'. The Court of Appeals found that it was "not implausible" that another artist would have been willing to purchase rights to produce a sculpture like Rogers' photograph, and that such a market had been reduced. 960 F.2d at 312.

The Second Circuit's approach was flawed in at least three critical respects. First, and most obviously, the court made factual findings, as is clear from its language. Second, and more fundamentally, the court departed from this Court's precedent, which requires a showing by "a preponderance of the evidence that some *meaningful likelihood* of future harm exists." *Sony Corp. of America v. Universal City Studios, Inc.*, *supra*, 464 U.S. at 451 (emphasis supplied). The reason for the rule is self-evident: "A use that has no *demonstrable effect* upon the potential market for, or the value of, the copyrighted work need not be prohibited in order to protect the author's incentive to create." *Id.* at 450 (emphasis supplied).

The Court of Appeals' "not implausible" test turns that rule on its head. A copyright owner may always be expected to hypothesize some way in which his or her work might conceivably have been exploited, and if the hypothesis is not overly "implausible," economic injury could always be found using the Court of Appeals' test. Such an approach, however, fails to respect the value of creative expression reflected in Section 107, and would do serious harm.

The Court of Appeals' approach also failed to recognize one of the essential attributes of parody and satire: Works that criticize or lampoon an underlying work rarely compete with them in the market, and thus rarely implicate the concerns of the copyright laws. *Consumers Union of the United States, Inc. v. General Signal Corp.*, 724 F.2d 1044, 1051 (2d Cir. 1983), *cert. denied*, 469 U.S. 823 (1984); *see* Light,

Parody, Burlesque, and the Economic Rationale for Copyright, 11 Conn. L. Rev. 615 (1979). To the extent that criticism may cause harm to an underlying work, such injury is not of the type protected against by the copyright laws. In *Fisher v. Dees*, 794 F.2d 432 (9th Cir. 1986), the Ninth Circuit stated:

> "Copyright law is not designed to stifle critics. . . . Accordingly, the economic effect of a parody with which we are concerned is not its potential to destroy or diminish the market for the original — any bad review can have that effect — but rather whether it *fulfills the demand* for the original. Biting criticism suppresses demand; copyright infringement usurps it."

794 F.2d at 437-38. There was simply no basis for the Second Circuit to conclude that Koons' sculpture usurped the market for anything that Rogers owned. If Rogers wishes to license others to make sculptural renditions of his photograph, he may do so. It is inconceivable that Koons' creation of idiosyncratic and grotesque parodies, which sold for more than $100,000 each, could interfere with Rogers' rights, or with the value of such a potential use.

CONCLUSION

The opinion of the Court of Appeals for the Second Circuit has created great uncertainty with respect to the applicability of the fair use doctrine to works of visual art that comment upon or criticize existing imagery. As described above, referential art has played a vital role in the history of artistic expression in this century, and has been a catalyst for debate and dialogue in many creative disciplines. Visual artists have traditionally taken comfort in the protections afforded to such commentary and criticism by means of the fair use doctrine, and by the prior decisions of this Court. Such comfort has been destroyed by the promulgation of a rule that ignores the expressive value of the work being judged, and holds that art ceases to be art when it is sold.

The Court of Appeals has cast serious doubt on artists' abilities to create and sell important works of artistic expression, the value of which have long been explicitly recognized by this Court. A significant chilling effect is already being felt as a result of the lower court's widely-publicized decision, and will continue to be felt unless this Court reviews that decision on a writ of certiorari.

For the foregoing reasons, *amicus curiae* National Artists Equity Association respectfully submits that this Court should grant the petition for a writ of certiorari to the Court of Appeals for the Second Circuit.

Dated: September 11, 1992.

Respectfully submitted,

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NATIONAL ARTISTS EQUITY ASSOCIATION

APPENDIX A

APPENDIX B

L.H.O.O.Q.

APPENDIX C

THAT'S THE WAY--IT SHOULD HAVE BEGUN! BUT IT'S HOPELESS!

THAT'S THE WAY--IT SHOULD HAVE BEGUN! BUT IT'S HOPELESS!
5

APPENDIX D

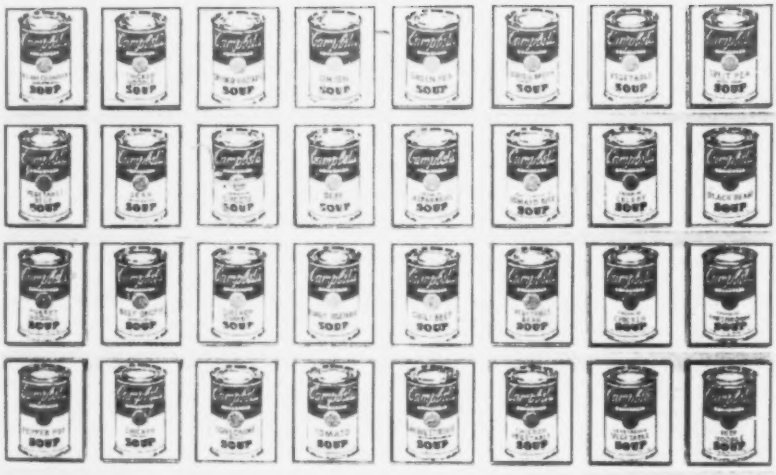
I DON'T CARE! I'D RATHER SINK -- THAN CALL BRAD FOR HELP!

RUN for LOVE!
I DON'T CARE IF I HAVE A CRAMP!— I'D RATHER DROWN— THAN CALL ANY ONE FOR HELP!

APPENDIX E

BALLANTINE
XXX
ALE
BALLANTINE
XXX
ALE

APPENDIX F


Campbell's
SOUP

APPENDIX G